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No.

In the Supreme Court of the United States

CATHERINE LACAVERA

Petitioner,

v.

JOHN W. DUDAS,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The U.S. Patent and Trademark Office ("USPTO") excludes nonimmigrant aliens from registration before the patent bar. Nonimmigrant aliens are aliens lawfully living and working in the United States pursuant to visas that are more restricted in duration and employment than the visas of immigrant aliens. The exclusion from the patent bar does not apply to immigrant aliens, U.S. citizens, or non-U.S. citizens who reside outside of the United States and who are registered to practice before a foreign patent office that offers reciprocal admission to persons registered to practice before the USPTO. The Court of Appeals for the Federal Circuit ("Federal Circuit") upheld the USPTO rule against a challenge that the rule exceeds the statutory authority of the USPTO and violates the equal protection aspect of the due process clause of the Fifth Amendment to the U.S. Constitution.

The questions presented are as follows:

1. Does the USPTO, in the exercise of its statutory authority to register patent practitioners who have the "necessary qualifications" to practice before it, have the authority to refuse to register nonimmigrant aliens as patent practitioners solely on the basis of their immigration status, where the nonimmigrant aliens are otherwise qualified for registration and authorized by United States Citizenship and Immigration Services ("USCIS") to practice as patent practitioners in the United States?

2. Did the Federal Circuit, in upholding a USPTO rule denying registration to nonimmigrant aliens, inappropriately apply only a "rational review"

standard where it should have applied at least "heightened scrutiny," if not "strict scrutiny," to a federal agency rule that discriminates against nonimmigrant aliens without serving any special national interest?

3. Do bar admission rules, such as the state rule that is before this Court in *Leclerc* v. *Webb* and *Wallace* v. *Calogero*, and the federal rule that is the basis of this case, that deny aliens lawfully within the United States access to employment opportunities based on the duration and employment restrictions of their current visas, violate the aliens' rights to "equal protection" in the absence of any evidence that the visa restrictions relate to valid state or federal interests in ensuring competency of practitioners?

RULE 14.1 STATEMENT

Petitioner (plaintiff-appellant below) is Catherine Lacavera.

Respondent (defendant-appellee below) is Jon Dudas in his capacity as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Lacavera respectfully petitions for a writ of certiorari to review the judgment of the Court of Appeals for the Federal Circuit in this case.

OPINIONS AND ORDERS BELOW

The opinion of the court of appeals (Appendix ("App."), *infra,* 3a-9a) is reported at *Lacavera* v. *Dudas*, 441 F.3d 1380 (Fed. Cir. 2006). The order of the court of appeals denying petitioner's petition for rehearing and rehearing *en banc* (App., *infra,* 1a-2a) is available at *Lacavera* v. *Dudas*, No. 05-1204, 2006 U.S. App. LEXIS 14779 (Fed. Cir. Jun. 5, 2006). The district court decision (App., *infra,* 10a-27a) is available at *Lacavera* v. *Toupin*, No. 03-1469, 2004 U.S. Dist. LEXIS 29205 (D.D.C. Nov. 30, 2004). The USPTO decisions refusing to register petitioner (App., *infra,* 38a-51a), and denying petitioner's petition for reconsideration (App., *infra,* 28a-37a), are part of the administrative record of the USPTO.

JURISDICTION

The judgment of the court of appeals was entered on February 6, 2006. Petitioner's timely petition for rehearing and rehearing *en banc* was denied on June 5, 2006. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISION, STATUTE AND REGULATION INVOLVED

The Fifth Amendment to the U.S. Constitution provides: "No person shall be ... deprived of life, liberty, or property, without due process of law ..." U.S. CONST. amend. V.

Section 2 of Title 35 of the United States Code provides, in relevant part:

> The Office ... may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of **good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance** in the presentation or prosecution of their applications or other business before the Office ...

35 U.S.C. § 2(b)(2)(D). The United States Patent and Trademark Office ("USPTO") adopted the following regulation pertaining to registration of patent attorneys:

> (a) Attorneys. Any citizen of the United States who is an attorney and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office. **When appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, provided: Registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States** and further provided: The alien may remain registered only (1) if the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which alien continues to lawfully reside in the United States or (2) if the alien ceases to reside in the United States, the

> alien is qualified to be registered under paragraph (c) of this section.
>
> ...
>
> (c) Foreigners. Any foreigner not a resident of the United States who shall file proof to the satisfaction of the Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices and who is possessed of the qualifications stated in § 10.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, provided: The patent office of such country allows substantially reciprocal privileges to those admitted to practice before the United States Patent and Trademark Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

37 C.F.R. § 10.6 (2003)[1] (emphasis added).

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[1] Effective July 26, 2004, the USPTO changed the requirements for registration of patent attorneys. As part of the changes, the USPTO removed and reserved 37 C.F.R. § 10.6-10.9 (2003), and replaced them by 37 C.F.R. § 11.6-11.9 (2004). *See* 69 Fed. Reg. 35428 (June 24, 2004). The new provision pertaining to registration is substantially the same as the former provision. 37 C.F.R. § 10.6 (2003) was the applicable and governing regulation at all times during petitioner's administrative action, and was applied by the district court. (App., *infra*, 13a n. 1.)

STATEMENT

Introduction. This case raises several important questions of federal law: first, whether a federal agency can exceed its statutory authority and usurp the authority of a separate federal agency, in this case whether the USPTO can deny patent bar registration based on the immigration status of nonimmigrant aliens[2] who are authorized by USCIS to practice as patent attorneys in the United States; second, whether a federal agency classification that disadvantages lawfully admitted nonimmigrant aliens without serving any special national interest should be subject to at least "heightened scrutiny," if not "strict scrutiny"; third, whether a federal agency classification that denies employment opportunities to nonimmigrant aliens who are otherwise qualified for such opportunities violates the nonimmigrant aliens' right to equal protection under the due process clause of the Fifth Amendment to the U.S. Constitution.

The USPTO denies patent bar registration to lawfully admitted nonimmigrant aliens, and registers only U.S. citizens, immigrant aliens, and non-U.S. citizens who reside outside of the United States and who are registered to practice before a foreign patent office that offers reciprocal admission to persons registered to practice before the USPTO. In lieu of registration, the USPTO offers nonimmigrant aliens only "limited recognition," the limits of which the USPTO defines

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[2] An alien is "any person not a citizen or national of the United States." 8 U.S.C. § 1101(a)(3). Nonimmigrant aliens are lawfully admitted aliens who fall within one of the categories listed in 8 U.S.C. § 1101(a)(15). Immigrant aliens are all other lawfully admitted aliens. *Id.*; see *Elkins v. Moreno*, 435 U.S. 647, 664 (1978).

on a case-by-case basis in a purported attempt to enforce the limitations in nonimmigrant aliens' visas.

This case is part of an emerging trend in the legal profession to impose on the subclass of nonimmigrant aliens barriers to employment opportunities that this Court already held unconstitutional when applied to the class of aliens. *See e.g.*, *In re Griffiths*, 413 U.S. 717 (1973) (holding that Connecticut court rules restricting admission to the bar to citizens only violate equal protection); *see also Hampton* v. *Mow Sun Wong*, 426 U.S. 88 (1976) (invalidating federal Civil Service Commission policy excluding aliens from most civil service jobs). There are two other cases presently pending before this Court that concern whether nonimmigrant aliens can be excluded from practice before the Louisiana state bar, *Leclerc* v. *Webb*, 419 F.3d 405 (5th Cir. 2005), *petition for cert. filed*, (U.S. Jun. 22, 2006) (No. 06-11), and *Wallace* v. *Calogero*, 419 F.3d 405 (5th Cir. 2005), *petition for cert. filed*, (U.S. Jun. 23, 2006) (No. 06-11). Another court recently upheld the Georgia Bar's extra documentation requirements for aliens, holding that the state has a strong interest in determining whether applicants are breaking immigration laws. *Godoy* v. *Office of Bar Admissions*, No. 1:05-0675, 2006 WL 2085318, at *4-5 (N.D. Ga. Jul. 25, 2006.)

The USPTO rule at issue in this case affects approximately 2.5 percent (approximately 100) of the approximately 4000 applicants for registration each year, who are aliens with visa restrictions and who are therefore denied registration. (Corrected Brief for Defendant-Appellee, at 8, *Lacavera* v. *Dudas*, No. 05-1204 (filed with Fed. Cir. on Jun. 20, 2005) [hereinafter *Def. Fed. Cir. Br.*]). The emerging trend towards erecting barriers to entry to professional employment opportunities stands to affect the over 30 million

nonimmigrant aliens lawfully present in the United States.[3] This Court's review is urgently needed to reverse the trend toward interfering with the authority of USCIS over immigration restrictions and impinging upon the constitutional rights of aliens lawfully residing in the United States.

The USPTO rule should be stricken because it exceeds the statutory authority of the USPTO and violates nonimmigrant aliens' right to equal protection. The USPTO has no Congressional authority to interpret or enforce immigration law. Yet it refuses to register nonimmigrant aliens that are authorized by USCIS to practice as patent practitioners in the United States. The USPTO purports to enforce visa restrictions by creating case-by-case limits on the recognition of nonimmigrant aliens that practice before it. The Federal Circuit decision to uphold the USPTO rule was a marked departure from prior precedents holding that an agency cannot expand its Congressionally-limited authority into an area over which it has no jurisdiction. *See e.g.*, *Adams Fruit Co., Inc.* v. *Barrett*, 494 U.S. 638, 650 (1990) (holding that the Department of Labor's statutory authority to promulgate safety standards cannot be used to bootstrap it into an area in which it has no jurisdiction); *Brown & Williamson Tobacco Corp.* v. *Food & Drug Admin.*, 153 F.3d 155, 161 (Fed. Cir. 1998), *reh'g and reh'g en banc denied*, 161 F.3d 764 (1998), *aff'd*, 529 U.S. 120 (2000) (invalidating FDA regulations of tobacco products because FDA lacks jurisdiction to regulate such products). The decision below invites any agency, regardless of its Congressional mandate, to expand its

[3] *See* Office of Immigration Statistics, U.S. Dep't of Homeland Security, 2004 Yearbook of Immigration Statistics, p. 123 Table 28 (Jan. 2006), available at http://www/uscis.gov/graphics/shared/statistics/yearbook/Yearbook2004.pdf.

authority to include creating and policing restrictions on aliens.

The USPTO rule denying registration to nonimmigrant aliens also violates the equal protection aspect of the due process clause of the Fifth Amendment. The Federal Circuit mistakenly applied only the "rational review" standard that is applicable to acts of Congress under *Mathews* v. *Diaz*, 426 U.S. 67, 78 (1976) (App., *infra,* 9a). However, this Court made clear in *Hampton* that in the case of a federal agency rule like the USPTO rule, the decision to deprive aliens of employment opportunities must be justified by reasons that are properly the concern of the agency. *Hampton*, 426 U.S. at 116. Since the USPTO has no special national interest in its discriminatory rule, at least "heightened scrutiny," if not "strict scrutiny," should have been applied to the USPTO rule denying registration to nonimmigrant aliens. *Cf. id.* at 100-105, *cf. Ramos* v. *U.S. Civil Service Comm'n*, 376 F. Supp. 361, 366 (D.P.R. 1974), *aff'd in relevant part*, 426 U.S. 916 (1976).

The Federal Circuit decision set a dangerous precedent by misapplying the law of equal protection to hold that the petitioner was not denied equal protection because the USPTO treats all nonimmigrant aliens the same by refusing to register any of them. (App., *infra,* 9a.) Equal discrimination is <u>not</u> equal protection. This Court established long ago that for purposes of equal protection analysis, "similarly situated" persons must be identified by criteria that threaten a legitimate interest of the agency. *City of Cleburne v. Cleburne Living Center, Inc.*, 473 U.S. 432, 448 (1985). Here, the USPTO treats qualified nonimmigrant aliens differently than all other qualified persons seeking registration before the patent bar by denying them registration. There is no evidence that an applicant's immigration status threatens any legitimate interest

of the USPTO in ensuring competency of patent practitioners. The decision below opens the door to any federal agency arbitrarily discriminating against nonimmigrant aliens without establishing even a rational basis for doing so.

Factual Background. Congress granted the USPTO the authority to require persons seeking registration before it "to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance ..." 35 U.S.C. § 2(b)(2)(D). The USPTO promulgated a rule that permits registration of aliens provided "[r]egistration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States" 37 C.F.R. § 10.6 (2003). According to the USPTO's interpretation of the rule, nonimmigrant status is "inconsistent" with registration because it is limited in time and scope whereas registration is not so limited. (*See e.g.*, App., *infra,* 46a.)

Petitioner is a nonimmigrant alien who possesses the legal, technical and character qualifications for registration to practice as a patent attorney set forth in 37 C.F.R. § 11.7. She has an engineering and a law degree (A111), and she is admitted to practice law before several state bars and federal courts, including this Court (A120-23, A209 and A224). She has been lawfully practicing patent law in the United States for nearly five years pursuant to a series of nonimmigrant visas. (A42; A46-47; A61-63; A80-81; A104-106; SRA 1-4.) Preparing and prosecuting patent applications are among the activities contemplated as within the scope of her visas. (*See e.g.*, A61-63, particularly A62.) She passed the patent registration examination administered on April 17, 2002. (A181.)

Proceedings Below. After passing the registration examination, by letter dated June 17, 2002, petitioner petitioned the USPTO for registration. (A225.) On July 8, 2002, the USPTO issued its Decision On Petition under 37 C.F.R. § 10.170 ("Decision on Petition"), denying petitioner's petition for registration. (App., *infra,* 38a-51a.) On August 6, 2002, petitioner filed a Petition for Review under 37 C.F.R. § 10.2(c) (2003), appealing the Decision on Petition. (A93-102.) USPTO affirmed in a Memorandum and Order ("Order") issued on May 9, 2003. (App., *infra,* 28a-37a.) On July 2, 2003, petitioner filed suit against the USPTO in the U.S. District Court for the District of Columbia, seeking review of the denial of registration. On November 30, 2004, the district court granted the USPTO's motion for summary judgment, affirming the refusal to register petitioner. (*Id.* at 10a-27a.) The district court accorded deference to the USPTO's interpretation of the statute empowering the USPTO to regulate patent practitioners, 35 U.S.C. § 2, because it found that the statute is silent on the issue of whether the USPTO may refuse to register nonimmigrant aliens. (*Id.* at 23a-25a.) It held that a "reasonable interpretation" of the statutory requirements of "good moral character" and "necessary qualifications" includes limiting recognition of nonimmigrant aliens to the terms of their visas. (*Id.* at 25a.) The district court further held that there was no violation of petitioner's right to equal protection because the USPTO treats all nonimmigrant aliens the same by denying registration to all of them. (*Id.* at 26a.) On December 9, 2004, petitioner filed a Notice of Appeal to the Court of Appeals for the Federal Circuit. On February 6, 2006, the Federal Circuit affirmed, and on June 5, 2006, it denied rehearing and denied rehearing en banc. (*Id.* at 2a, 9a.)

REASONS FOR GRANTING THE PETITION

This Court's review is necessary to clarify the bounds of federal agency authority and to determine whether a federal agency with no statutory authority over immigration and naturalization can discriminate against nonimmigrant aliens without serving any legitimate interest of that agency.

I. The Federal Circuit Erroneously Empowered The USPTO To Usurp The Authority Of The USCIS By Refusing To Register As Patent Practitioners Nonimmigrant Aliens Authorized By USCIS To Practice Patent Law In the United States

This case presents an important opportunity for this Court to rein in the tendency of the USPTO, or any federal or state agency, to expand its authority into creating and policing immigration restrictions. The decision below erroneously permitted the USPTO to expand its authority into this area over which it has no jurisdiction.

Congress authorized the USPTO to evaluate practitioners' competency to practice before it, not the terms of practitioners' visas. The USPTO's authority to govern the recognition and conduct of attorneys is expressly limited to consideration of whether the attorney seeking registration has "good moral character" and the "necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation and prosecution of their applications or other business before the Office ..." 35 U.S.C. § 2(b)(2)(D). The plain meaning of "necessary qualifications" refers to technical and legal competence to prepare and prosecute patent applications. There is nothing in that sentence, the statute as a whole, or the available legislative history to suggest that "necessary qualifications" was intended

to include citizenship or immigration status. *Id.*; *see* S.R. No. 1979 (1952); S.R. No. 93-1399 (1974); *see also* CONSOLIDATED APPROPRIATIONS ACT, Pub. L. No. 106-113, § 4608-4808 (1999). Because Congress expressly limited the requirements the USPTO may impose on attorneys, and those requirements do not include U.S. citizenship or immigration status, the USPTO had no discretion to impose such requirements. *Chevron U.S.A., Inc.* v. *Natural Resources Defense Council, Inc.*, 467 U.S. 837, 842-43 (1984) ("If the intent of Congress is clear, that is the end of the matter; for the court, as well as the agency, must give effect to the unambiguously expressed intent of Congress."), *reh'g denied*, 468 U.S. 1227 (1984).

Furthermore, the USPTO's own rules establish that citizenship and immigration status are not "necessary qualifications" for registration because the rules permit registration of Canadian citizens residing in Canada, practicing Canadian patent law and possessing no immigration status in the United States. 37 C.F.R. § 10.6 (2003).

The Federal Circuit mistakenly held that the USPTO denied petitioner registration because the USPTO interpreted "necessary qualifications" to include "legal authority to render service." (App., *infra,* 8a-9a.) If this were correct, petitioner would have been registered as a patent attorney because she possesses legal authority to render service: her visa authorizes her to practice as a patent attorney in the United States. (*See e.g.*, A61-63, particularly A62.) Nothing in her visa precludes her from being registered. Registration would not relieve her of the obligation to comply with her visa.

The Federal Circuit decision in this case, and the trend in cases like *Leclerc* and *Wallace*, would permit any federal agency or state bar to erect barriers to professional

employment opportunities for the purported purpose of policing immigration restrictions. This is the business of the Department of Homeland Security ("DHS").[4] No other agency has been entrusted by Congress with this authority. No other agency is qualified to perform this function.

The USPTO has demonstrated its inability to interpret and enforce visa restrictions properly by its repeated changes throughout this lawsuit to the USPTO rules and the terms of petitioner's limited recognition,[5] in purported attempts to

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[4] On March 1, 2003, the functions of the Immigration and Naturalization Service were transferred from the Department of Justice to three agencies (United States Immigration and Customs Enforcement, United States Customs and Border Protection, and USCIS) to the newly formed DHS. *See* HOMELAND SECURITY ACT OF 2002, Pub. L. No. 107-296, 116 Stat. 2135 (2002); *Kalaj* v. *Gonzales*, No. 05-3172, 2006 U.S. App. LEXIS 15490, *2 n.1 (6th Cir. 2006).

[5] After petitioner argued that her limited recognition was more restrictive than her visa because it forced her to work for a fully registered practitioner causing inefficiencies for clients (Corrected Brief for Plaintiff-Appellant, at 32-33, *Lacavera* v. *Dudas*, No. 05-1204 (filed with Fed. Cir. on Apr. 1, 2005 [hereinafter *Pl. Fed. Cir. Br.*]), the USPTO lifted this restriction (*compare* SRA5 *and* A207). After petitioner argued that she was denied a registration number and forced to submit copies of her limited recognition records in each patent application (*Pl. Fed. Cir. Br.*, at 32-33), the USPTO informed petitioner of its new policy of issuing limited recognition numbers to be used in lieu of filing proof of her limited recognition status. (A225.) The USPTO initially refused to reconsider its policy of requiring annual renewal of limited recognition status despite the three year term of petitioner's visa (*see* A25-27, A203-207), but then it changed its rules to grant limited recognition commensurate with the term of the nonimmigrant alien's visa (*compare* 37 C.F.R. 11.9 (2004) *and* 37

achieve "consistency" between petitioner's limited recognition before the USPTO and the terms of her visa. Still today, after over four years of pendency of this case and multiple amendments by the USPTO to its regulations and the terms of petitioner's limited recognition status, petitioner's limited recognition is still far more restrictive than her visa.[6] These restrictions impede petitioner's ability to perform functions that she was expressly authorized by USCIS to perform in the United States, namely preparing and prosecuting patent applications. A real danger of permitting the USPTO, or any other agency that has no authority over immigration matters, to enforce immigration restrictions is that the agency could impose its own set of arbitrary and burdensome restrictions on aliens, just as the USPTO did here.

II. The Federal Circuit Erred When It Applied Only "Rational Review" To A USPTO Rule That Discriminates Based On Alienage Without Serving Any National Interest

This case is a perfect opportunity for the Court to clarify the appropriate degree of scrutiny of a federal agency rule that discriminates on the basis of alienage where the federal agency has no special national interest in its discriminatory rule.

C.F.R. § 10.9 (2003)).

[6] Petitioner's current limited recognition before the USPTO limits her to "prepar[ing] and prosecut[ing] patent applications wherein the assignee of record of the entire interest is [petitioner's employer]" (SRA 5), whereas her visa authorizes her to represent her employer by preparing and prosecuting patent applications regardless of the assignee of record (SRA 1-4).

The Federal Circuit applied only a "rational review" standard in upholding the USPTO rule (App., *infra,* 9a.), citing *Mathews*, 426 U.S. at 78, a case which concerned the constitutionality of provisions in the Social Security Act denying Medicare benefits to nonimmigrant aliens. This case asks the court to consider whether a federal agency rule, as opposed to an act of Congress as was at issue in *Mathews*, which discriminates against nonimmigrant aliens without serving any special national interest should be subject to at least "heightened scrutiny," if not the "strict scrutiny" accorded to similarly discriminatory rules promulgated by the states.

This Court has repeatedly held that state "classifications based on alienage [are] inherently suspect and subject to close judicial scrutiny." *See e.g.*, *Graham* v. *Richardson*, 403 U.S. 365, 372 (1971) (applying strict scrutiny review in equal protection challenge to state law that affected only aliens who had not resided in the state for a certain period of time); *see also Nyquist* v. *Mauclet*, 432 U.S. 1, 7 (1977) (applying strict scrutiny to invalidate state law that prevented certain aliens from applying for state financial assistance for higher education). But the USPTO distinguished the long line of cases holding it unconstitutional to deny aliens admission to practice law or any other profession[7] on the basis that these

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[7] *See In re Griffiths*, 413 U.S. at 717 (Connecticut court rules restricting admission to the bar to citizens found to deny equal protection); *see also Szeto* v. *Louisiana State Board of Dentistry*, 508 F. Supp. 268 (E.D. La. 1981) (state statute prohibiting aliens from being licensed to practice dentistry violated equal protection clause); *see also Surmeli* v. *State of New York*, 412 F. Supp. 394 (S.D.N.Y. 1976), *aff'd*, 556 F.2d 560 (2d Cir. 1976), *cert. denied*, 436 U.S. 903 (1978) (state's requirement of citizenship or declaration of intent to become a citizen as condition of continued licensure after it had already found alien physician qualified and

cases involved state rather than federal rules. (*Def. Fed. Cir. Br.*, at 45.)

It has been recognized that federal laws that classify on the basis of alienage may receive less searching judicial review than state laws that classify on that basis because of the paramount federal power over immigration and naturalization. *Hampton*, 426 U.S. at 100-101. However, this Court held that where there is no special national interest at stake, the due process clause applicable to the federal government has the same significance as the equal protection clause of the Fourteenth Amendment applicable to the states. *Hampton*, 426 U.S. at 100 (citations omitted). Thus, "[a]s classifications based upon alienage are now also "suspect", it would seem that a classification of aliens which, if state-made, violates equal protection will, if federally made, violate due process." *Ramos*, 376 F. Supp. at 366, *aff'd in relevant part*, 426 U.S. at 916.).

This Court made clear in *Hampton* that federal regulation of aliens receives less searching review only if the federal government asserts an overriding national interest as a justification for an otherwise discriminatory rule and the agency that promulgates the rule has direct responsibility for fostering or protecting that interest. *Hampton*, 426 U.S. at 100-116. In *Hampton*, this Court held that a Civil Service Commission policy excluding aliens from civil service jobs was not designed to foster any national interest in alien naturalization because that interest was far removed from the responsibilities of that agency. *Id.* at 104-105. Similarly, the USPTO's discriminatory regulation is not designed to foster

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licensed him to practice bore no logical relationship to his continued professional competence, and therefore violated equal protection clause).

any national interest in alien naturalization because that interest is not even remotely related to the interest of the USPTO in ensuring competency of those that practice before it.

The USPTO interest in ensuring competency of registered patent attorneys is no different than the interest of every state bar in ensuring competency of practicing attorneys. The question whether a federal agency like the USPTO can deny nonimmigrant aliens registration before the patent bar is analogous to the question presented in two other cases presently before this court, *Leclerc* and *Wallace*, whether the state of Louisiana can deny nonimmigrant aliens admission to the Louisiana state bar. The only distinction in this case is whether a federal agency may discriminate against nonimmigrant aliens if this Court concludes in *Leclerc* and *Wallace* that a state is prohibited from the same manner of discrimination. This Court has already answered this question in the negative. *See Hampton*, 426 U.S. at 100-116; *see also Ramos*, 376 F. Supp. at 361, *aff'd in relevant part*, 426 U.S. at 916. This Court affirmed that "Congress itself, when legislating generally on matters not related to the furtherance of its naturalization responsibilities, may not single out aliens for discriminatory treatment forbidden to the states." *See Ramos*, 376 F. Supp. at 366, *aff'd in relevant part*, 426 U.S. at 916. Thus the USPTO rule should be subjected to at least "heightened scrutiny", if not the same degree of "strict scrutiny" applied to state regulations that discriminate against aliens. *See Graham*, 403 U.S. at 371-72; *Nyquist*, 432 U.S. at 8-9.

III. The Federal Circuit Erred By Holding Equal Discrimination Against Nonimmigrant Aliens Satisfies the Equal Protection Guarantee

The Federal Circuit set a dangerous precedent by holding that the USPTO does not discriminate against nonimmigrant aliens because it treats all nonimmigrant aliens the same by refusing to register any of them. (App., *infra,* 9a.) Equal discrimination is not equal protection. This Court has made clear that for purposes of equal protection analysis, "similarly situated" persons must be defined based on criteria that threaten a legitimate USPTO interest. In *City of Cleburne*, for example, the U.S. Supreme Court invalidated a city zoning ordinance and held that although the mentally retarded as a group are different from others not sharing their misfortune, this difference does not threaten a legitimate interest of the city that could justify treating them differently. 473 U.S. at 448.

On its face, the USPTO rule governing registration of patent practitioners discriminates between (a) U.S. citizens, who are registered regardless of their country of residence; and (b) aliens, who may be registered only if (i) they reside in the United States pursuant to a work visa the terms of which are not "inconsistent" with registration or (ii) reside outside the United States and are registered before the patent office in their jurisdiction of residence, and where such foreign patent office offers reciprocal privileges to persons registered before the USPTO. 37 C.F.R. § 10.6 (2003). The USPTO rule imposes residency requirements on aliens -- either permanent residence in the United States or, ironically, residence outside of the United States -- that are not imposed on U.S. citizens. The USPTO refuses to register nonimmigrant aliens, who are temporary residents, even if they are authorized by USCIS to practice as patent practitioners in the United States because the

USPTO claims that registration is "inconsistent" with the duration and employer restrictions in their visas.

The USPTO presented no evidence that the immigration status of attorneys seeking registration before the USPTO threatens a legitimate interest of the USPTO in ensuring competency of those that practice before it. In fact, by granting full registration under 37 C.F.R. § 10.6(c) (2003) to non-U.S. citizens who reside outside the United States and possess no immigration authority to work in the United States, the USPTO has indicated that citizenship and immigration status are not important considerations. The USPTO's own regulations establish that the relevant requirements for establishing competency of patent practitioners are the technical, legal and moral qualifications of applicants. 37 C.F.R. § 10.7 (2003). The USPTO's "Requirements for Registration," do not, and should not, include any requirement of citizenship or immigration status. *Id.* Thus, "similarly situated persons" under *City of Cleburne* for purposes of patent attorney registration, are those who have satisfied 37 C.F.R. § 10.7 (2003). Petitioner met all of these requirements, and yet she was denied registration because she is not a U.S. citizen or permanent resident of the United States. Petitioner and other qualified nonimmigrant aliens are treated differently than all other similarly situated persons who have met the USPTO requirements for registration.

The Federal Circuit mistakenly held that the "[USPTO] regulations in question are rationally related to a legitimate government interest, e.g. minimizing the unauthorized practice of law before the USPTO and its attendant public harm." (App., *infra,* 9a.) This finding is based on pure conjecture. There is no evidence to support the Federal Circuit's assumption that denying nonimmigrant aliens full registration and granting only limited recognition serves any

legitimate interest of the USPTO, much less any supposed interest in minimizing unauthorized practice before the USPTO. There is no evidence that aliens with work visa restrictions are more likely to engage in the unauthorized practice of law before the USPTO than any other class of applicant for registration. There is no evidence that any public harm would attend the grant of registration to aliens with work visa restrictions. There is no reason to believe that nonimmigrant aliens are more likely to leave their clients without adequate representation than U.S. citizens who may remain registered to practice before the USPTO even if they leave the United States, immigrant aliens who may remain registered if they move within the United States, or Canadian citizens with no U.S. immigration status who are registered if the reside within Canada.

The USPTO claimed that limited recognition enables the USPTO to "monitor that resident aliens cease to practice when their employment authorization expires." (*Def. Fed. Cir. Br.*, at 32). Without limited recognition, the USPTO claims it "would be forced to use its investigative power to determine whether petitioner's representations to clients and the USPTO are in concert with her visa restrictions." (*Id* at 50). To the extent the USPTO has any authority to monitor aliens' compliance with their visas, given that it has no responsibility for immigration and naturalization, that authority is no different than the USPTO's authority to monitor all registered practitioners' compliance with all laws of the United States. There is no evidence that monitoring aliens' compliance with the terms of their visas is any more pressing a concern of the USPTO than monitoring all registrants' compliance with all laws of the United States. Therefore, the claimed need to monitor nonimmigrant aliens is no justification for treating nonimmigrant aliens differently.

The USPTO regulations are also not narrowly tailored to serve the claimed interests of the USPTO in preventing unauthorized practice before it and protecting the public. The USPTO denies registration to all nonimmigrant aliens based on its presumption that all aliens are likely to engage in unauthorized practice before it by violating their visas or abandon their clients by returning to their native countries. The USPTO does not consider how long each nonimmigrant alien has lawfully resided in the United States in compliance with his or her visa or whether the nonimmigrant has applied for immigrant status. In petitioner's case for example, she has been lawfully living and working in the United States for nearly five years in compliance with her visas (A42; A46-47; A61-63; A80-81; A104-106; SRA 1-4) and she has applied for and is awaiting immigrant status.

The USPTO also has other adequate remedies to prevent nonimmigrant aliens from engaging in unauthorized practice before it: the USPTO can discipline registered attorneys and/or revoke their registration if they actually violate their visas or break any other law. There is no justification for denying aliens registration because they might violate their visas.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

Catherine Lacavera
2400 W El Camino Real, Apt. 920
Mountain View, CA 94040
Petitioner

September 5, 2006

APPENDIX A

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

No. 05-1204

[Filed June 5, 2006]

CATHERINE LACAVERA,
Plaintiff-Appellant,

v.

JON W. DUDAS, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office,
Defendant-Appellee.

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellant, and a response thereto having been invited by the court and filed by the Appellee, and the petition for rehearing and response, having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on June 12, 2006.

FOR THE COURT,

/s/ Jan Horbaly
Jan Horbaly
Clerk

APPENDIX B

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

No. 05-1204

[Filed February 6, 2006]

CATHERINE LACAVERA,

Plaintiff-Appellant,

v.

JON W. DUDAS, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office,

Defendant-Appellee.

Before NEWMAN, MAYER, and GAJARSA, Circuit Judges.

OPINION

MAYER, Circuit Judge.

Catherine Lacavera appeals the judgment of the United States District Court for the District of Columbia denying her motion for summary judgment and granting summary

judgment in favor of the United States Patent and Trademark Office ("PTO"). *Lacavera v. Toupin*, 2004 U.S. Dist. LEXIS 29205, Civ. Action No. 03-1469 (D.D.C. Nov. 30, 2004).* Because the PTO's decision to grant Lacavera limited recognition was consistent with its regulations and supported by the record, its regulations do not exceed the statutory authority, and it did not deny Lacavera equal protection, we affirm.

Background

The PTO has statutory authority to regulate attorney practice before it pursuant to 35 U.S.C. § 2(b)(2)(D) (2000), which provides:

> the [PTO] may establish regulations, not inconsistent with law, which . . . may govern the recognition and conduct of . . . attorneys . . . representing applicants or other parties before the Office, and may require them . . . to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office . . . .

From this authority, the PTO has issued regulations to govern the recognition of attorneys. Under 37 C.F.R. § 10.7(a)(2)

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* During the pendency of this appeal, at the PTO's request and with Lacavera's consent, Jon W. Dudas, Director of the PTO, was substituted for James Toupin, PTO General Counsel, as the defendant-appellee.

(2003),** in order to be registered, an individual must establish that she is "[o]f good moral character and repute; . . . [p]ossessed of the legal, scientific, and technical qualifications . . . and . . . otherwise competent to advise and assist applicants for patents." An alien "may be registered . . . provided . . . [r]egistration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States." 37 C.F.R. § 10.6(a). Aliens for whom registration would be inconsistent with legal restrictions imposed on them may, nevertheless, be granted "limited recognition," *see id.* § 10.9(b), a status which allows them to practice before the PTO, but confines their activities to those authorized by the Immigration and Naturalization Service ("INS"), now the United States Bureau of Citizenship and Immigration Services. With respect to nonimmigrant aliens, the PTO has interpreted section 10.9(b) to dictate that they are not registered upon passing the patent examination, but rather are "given limited recognition under 37 CFR § 10.9(b) if recognition is consistent with the capacity of employment authorized by the INS." *See* PTO, General Requirements Bulletin (Nov. 3, 1999) ("GRB").

Lacavera, a Canadian citizen and nonimmigrant alien, began working in the United States as an attorney in

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** Effective July 26, 2004, the PTO changed its regulations pertaining to the representation of others. *See* 69 Fed. Reg. 35428 (June 24, 2004). As a result of these changes, sections 10.6, 10.7, and 10.9 were removed and reserved, and the applicable regulations governing the representation of others are now found at sections 11.6, 11.7, and 11.9. *See* 37 C.F.R. § 11 (2005). Sections 10.6, 10.7, and 10.9 were, however, the governing regulations for Lacavera's administrative action and her request for judicial review before the trial court. Hence, in reviewing the trial court's decision, we use sections 10.6, 10.7, and 10.9.

September 2001 pursuant to a one year TN visa, which permitted her only to prepare and prosecute patent applications at the New York office of the White & Case law firm. In January 2002, Lacavera began the application process for recognition before the PTO, and she successfully passed the April 17, 2002, patent examination. Because of legal restrictions imposed by her visa, she was granted limited recognition. Although Lacavera's visa had a one year duration, she received timely extensions from the INS, and the PTO extended her limited recognition period accordingly. At the time this appeal was filed, Lacavera held an H-1B visa and, with the appropriate INS authorization, had changed employers. Her present visa has a three year duration and lists preparation and prosecution of patent applications for Google, Inc. as her sole employable activity. Her current limited recognition status is consistent with her work and time restrictions.

After Lacavera was initially granted limited recognition on July 8, 2002, she challenged the PTO's decision to deny her full registration. The PTO General Counsel denied her challenge, and Lacavera filed suit in the United States District Court for the District of Columbia under the Administrative Procedure Act, 5 U.S.C. §§ 702-706 (2000), claiming that (1) the PTO's decision was inconsistent with its regulations, (2) the regulations exceeded the authority of their enabling statute, and (3) the PTO's decision denied her equal protection. The trial court denied Lacavera's motion for summary judgment and granted summary judgment in favor of the PTO. Lacavera appeals, and we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

Discussion

We review the trial court's grant of summary judgment without deference, reapplying the same standard as the trial court. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005). Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). Applying this standard, we reject each of Lacavera's arguments.

Lacavera contends that the PTO's decision was an abuse of discretion because it improperly found full registration inconsistent with the legal restrictions imposed by her visa. "An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors." *Star Fruits*, 393 F.3d at 1281. The "scope of review under [this] standard is narrow and a court is not to substitute its judgment for that of the agency." *Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43, 103 S. Ct. 2856, 77 L. Ed. 2d 443 (1983). Moreover, "an agency's interpretation of its own regulations is entitled to substantial deference and will be accepted unless it is plainly erroneous or inconsistent with the regulation." *Star Fruits*, 393 F.3d at 1282.

The PTO based its decision to grant limited recognition on the interpretation of section 10.9(b) found in the GRB, an interpretation that we believe reasonably interprets that regulation, and on its conclusion that Lacavera's visa

restrictions were inconsistent with full recognition. Because granting Lacavera full registration would have given her PTO approval to do work in which she could not lawfully engage, we find no abuse of discretion in the PTO's determination that granting her full registration was inconsistent with the terms of her visa. Moreover, the decision to grant limited recognition with restrictions consistent with those in her visa correctly applied sections 10.6(a) and 10.9(b) and the GRB, and was, therefore, not an abuse of discretion or arbitrary and capricious.

Lacavera next argues that the PTO exceeded the authority granted to it by 35 U.S.C. § 2(b)(2) in promulgating regulations that take into account visa restrictions when determining whether or not to grant full recognition. Under 35 U.S.C. § 2(b)(2), the PTO has broad authority to govern the conduct of proceedings before it and to govern the recognition and conduct of attorneys. *See Stevens v. Tamai*, 366 F.3d 1325, 1333 (Fed. Cir. 2004). Because the PTO is specifically charged with administering this statute, we analyze a challenge to the statutory authority of its regulations under the *Chevron* framework. *See United States v. Mead Corp.*, 533 U.S. 218, 121 S. Ct. 2164, 150 L. Ed. 2d 292 (2001); *Chevron U.S.A. Inc. v. NRDC*, 467 U.S. 837, 104 S. Ct. 2778, 81 L. Ed. 2d 694 (1984). First, we determine whether the statute speaks to the issue of the challenge, and if it is silent or ambiguous, we defer to the agency's reasonable interpretation. *See Chevron*, 467 U.S. at 842-43.

In this case, the statute is silent as to whether the PTO may consider visa restrictions in determining whether or not to grant recognition. However, the statute states that the PTO "may require [applicants] . . . to show that they are . . . possessed of the necessary qualifications to render to applicants . . . valuable service." 35 U.S.C. § 2(b)(2)(D)

(emphasis added). It was reasonable for the PTO to interpret legal authority to render service as being a necessary qualification. Accordingly, it was reasonable for the PTO to enact regulations that limit an alien's ability to practice before it to those activities in which the alien may lawfully engage. Therefore, the PTO did not exceed its statutory authority in promulgating the regulations in question.

Finally, Lacavera contends that she was denied equal protection. We review her claim under the rational review standard. *See Mathews v. Diaz*, 426 U.S. 67, 78, 96 S. Ct. 1883, 48 L. Ed. 2d 478 (1976). Lacavera offered no evidence that she was treated unequally as compared to other aliens with visa restrictions, and therefore she suffered no individual equal protection violation. *See City of Cleburne v. Cleburne Living, Inc.*, 473 U.S. 432, 439, 105 S. Ct. 3249, 87 L. Ed. 2d 313 (1985). Moreover, because the regulations in question are rationally related to a legitimate government interest, *e.g.*, minimizing the unauthorized practice of law before the PTO and its attendant public harm, they do not violate the equal protection clause and are, therefore, valid. *Id.* at 440.

Conclusion

Accordingly, the judgment of the United States District Court for the District of Columbia is affirmed.

COSTS

No costs.

AFFIRMED

APPENDIX C

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 03-1469 (JDB)

[Filed November 30, 2004]

CATHERINE LACAVERA	)
	)
Plaintiff,	)
	)
v.	)
	)
JAMES TOUPIN, GENERAL COUNSEL, UNITED STATES PATENT AND TRADEMARK OFFICE	)
	)
Defendant.	)

ORDER

Upon consideration of petitioner's motion for summary judgment, defendant's motion for summary judgment, the several memoranda filed by the parties, and for the reasons stated in the Memorandum Opinion issued on this date, it is this 30th day of November, 2004, hereby

ORDERED that petitioner's motion for summary judgment is DENIED, and it is further

ORDERED that defendant's motion for summary judgment is GRANTED. Judgment is therefore entered in favor of defendant.

/s/ John D. Bates
JOHN D. BATES
United States District Judge

APPENDIX D

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 03-1469 (JDB)

[Filed November 30, 2004]

CATHERINE LACAVERA,)
)
Plaintiff,)
)
v.)
)
JAMES TOUPIN, GENERAL COUNSEL,)
UNITED STATES PATENT AND)
TRADEMARK OFFICE,)
)
Defendant.)

JUDGES: JOHN D. BATES, United States District Judge.

MEMORANDUM OPINION

In this action, petitioner Catherine Lacavera ("Lacavera" or "petitioner") seeks judicial review of the decision of the General Counsel of United States Patent and Trademark Office ("USPTO") denying her challenge to the Director of the Office of Enrollment and Discipline's ("OED") decision to grant her limited recognition under 37 C.F.R. § 10.9(b)

(2003)[1], rather than full registration as a patent attorney under 37 C.F.R. § 10.6(a). Presently before the Court are cross motions for summary judgment filed by the parties. For the following reasons, the Court will deny petitioner's motion for summary judgment and grant USPTO's motion for summary judgment.

BACKGROUND

A. Regulatory Regime

The USPTO is responsible for registering trademarks and issuing patents. *See generally* 37 C.F.R. Parts 1-7. Due to the complexity of applications for trademarks and patents, applicants frequently rely upon the advice of patent attorneys and others who represent applicants before the USPTO. The USPTO has long been responsible for regulating those that represent applicants before the USPTO.

Pursuant to 35 U.S.C. § 2, the USTPO has issued regulations setting minimum standards for the recognition of patent attorneys. Under 35 U.S.C. § 2(b)(2)(D), the USPTO "may establish regulations, not inconsistent with law, which

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[1] Effective July 26, 2004 the USPTO changed the regulations pertaining to representation of others before the USPTO. *See* 69 Fed. Reg. 35428 (June 24, 2004). As a result of these changes sections 10.6 and 10.9 were removed and reserved. The applicable regulations pertaining to representation of others before the USPTO are now found in sections 11.6 and 11.9. Sections 10.6 and 10.9 were, at all times relevant to petitioner's administrative action and request for judicial review, the applicable and governing regulations. Hence in reviewing the decision of the USPTO, the Court will use sections 10.6 and 10.9, which governed the USPTO's contemporaneous decision.

. . . may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office. . . ." This statutory mandate for registration and recognition of patent attorneys is carried out in 37 C.F.R. § 10.6 ("Registration of attorneys and agents"), § 10.7 ("Requirements for registration"), and § 10.9 ("Limited recognition in patent cases"). Under 37 C.F.R. § 10.7, in order to be registered to practice before the USPTO an individual must apply in writing and establish that the individual is "of good moral character and repute; possessed of the legal, scientific and technical qualifications . . . and is otherwise competent to advise and assist applicants for patents." Furthermore, an individual has to pass an examination as part of the registration process. *See* 37 C.F.R. § 10.7(b).

Recognition of attorneys by the USPTO is also governed by 37 C.F.R. § 10.6(a), which states, in part:

> When appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, provided: Registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further provided: The alien may remain registered only (1) if the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or (2) if the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 10.9(b).

In turn, 37 C.F.R. § 10.9(b), states that "[w]hen registration of a resident alien under paragraphs (a) or (b) of section 10.6 is not appropriate, the resident alien may be given limited recognition as may be appropriate under paragraph (a) of this section."

In addition to these regulations, on November 3, 1999, the USPTO's General Requirements Bulletin addressed the issue of recognition of aliens. The General Requirements Bulletin is promulgated by the Commissioner of the USPTO and interprets USPTO regulations. *See Premysler v. Lehman*, 71 F.3d 387, 389 (Fed. Cir. 1996) ("The Commissioner promulgated the General Requirements Bulletin to interpret this regulation."). The November 3, 1999 Bulletin stated that "[q]ualifying non-immigrant aliens within the scope of 8 C.F.R. § 274a.12(b) or (c) are not registered upon passing the examination. Such aliens will be given limited recognition under 37 C.F.R. 10.9(b) if recognition is consistent with the capacity of employment authorized by the INS."

B. Facts

Petitioner Lacavera is an attorney and Canadian citizen living in New York. *See* Def.'s Statement of Material Facts not in Genuine Dispute ("Def.'s Statement") ¶ 1. Petitioner was authorized by the Immigration and Naturalization Service ("INS") to work as a professional pursuant to the North American Free Trade Agreement, pursuant to what is known as a TN visa. *Id.* ¶ 3. By the terms of her TN visa, petitioner was permitted to work only at the New York law firm of White & Case preparing and prosecuting patent applications. *Id.* ¶ 4. Although petitioner's TN visa was limited to a one year duration, at all times relevant to this case petitioner has received extensions to her TN visa, and it has not expired. *Id.* ¶ 5.

On January 3, 2002, petitioner applied to the USPTO to take the April 17, 2002, examination required to become registered to practice before the USPTO. *Id.* ¶ 2. By letter dated February 20, 2002, USPTO informed petitioner that her application to take the examination was approved. *Id.* ¶ 6. In the same letter, however, USPTO informed petitioner that because she is a nonimmigrant alien with a limited right to work in the United States, if she passed the exam she would be eligible for limited recognition under. 37 C.F.R. § 10.9(b), instead of the usual patent attorney registration under 37 C.F.R. §§ 10.6(a) or (b). *Id.* ¶ 7.

On April 17, 2002, petitioner took the patent examination. *Id.* ¶ 8. On June 3, 2002, the USPTO's Office of Enrollment and Dicipline ("OED") informed petitioner that she had passed the exam. *Id.* ¶ 9 OED also requested more information from petitioner before they could grant her limited recognition. *Id.* Petitioner provided that additional material and then on July 8, 2002, the OED Director granted petitioner limited recognition under 37 C.F.R. § 10.9(b) to prepare and prosecute patents before the USPTO on behalf of White & Case clients. *Id.* ¶¶ 10, 11. Petitioner's limited recognition from OED had an expiration date of August 2, 2002, which corresponded with the expiration of petitioner's TN visa. *Id.* ¶ 11. The OED extended petitioner's limited recognition status upon information from petitioner that her TN visa was extended. *Id.* ¶ 12. Then on August 6, 2002, petitioner challenged the decision of the OED Director to grant her limited recognition rather than full recognition. *Id.* ¶ 13.

On March 26, 2003, petitioner again asked OED for an extension to her limited recognition because her visa status had changed from a TN visa to an H-1B visa. *Id.* ¶ 14. Petitioner's new H-1B visa expired on January 1, 2006, but

the same work restrictions applied -- petitioner could only work for White & Case preparing and prosecuting patent applications. *Id.* ¶ 15. On April 3, 2003 the OED Director granted petitioner limited recognition under 37 C.F.R. § 10.9(b) until April 3, 2004. *See* Compl.¶ 12. In that same letter the OED Director informed petitioner she could continue to receive extensions on her limited recognition status so long as she maintained her current H-1B visa status. Def.'s Statement ¶ 18. On May 9, 2003, the USPTO General Counsel, James Toupin, denied petitioner's challenge to the decision of the OED Director to grant petitioner limited recognition. *Id.* ¶ 17. Petitioner thereafter filed this action seeking judicial review of that determination on July 2, 2003.

STANDARD OF REVIEW

This case is before the Court on cross-motions for summary judgment. Summary judgment is appropriate when the pleadings and the evidence demonstrate that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c). In this case, however, as is true generally for judicial review of agency action, the Court's review is limited to the administrative record. *See Camp v. Pitts*, 411 U.S. 138, 142, 93 S. Ct. 1241, 36 L. Ed. 2d 106 (1973). Petitioner challenges a final agency action under 5 U.S.C. § 702, which provides that "[a] person suffering legal wrong because of agency action, or adversely affected or aggrieved by agency action within the meaning of a relevant statute, is entitled to judicial review thereof." In reviewing an agency action, this Court is governed by the "arbitrary and capricious" standard set out in the APA, 5 U.S.C. § 706(2)(A). This is a highly deferential standard of review, which presumes that agency action is valid. *See, e.g., Kisser v. Cisneros*, 304 U.S. App. D.C. 317, 14 F.3d 615, 618 (D.C. Cir. 1994). The "scope of

review under the 'arbitrary and capricious' standard is narrow and a court is not to substitute its judgment for that of the agency." *Motor Vehicle Mfrs. Ass'n of U.S., Inc. v. State Farm Mut. Auto, Ins. Co.*, 463 U.S. 29, 43, 103 S. Ct. 2856, 77 L. Ed. 2d 443 (1983). A court may reverse only if the agency's decision is not supported by substantial evidence, or the agency made a clear error in judgment. *Citizens to Preserve Overton Park v. Volpe*, 401 U.S. 402, 415-16, 91 S. Ct. 814, 28 L. Ed. 2d 136 (1971). "The key to the arbitrary and capricious standard is its requirement of reasoned decision-making: we will uphold the [agency's] decision if, but only if, we can discern a reasoned path from the facts and considerations before the [agency] to the decision it reached." *Neighborhood TV Co. v. FCC*, 239 U.S. App. D.C. 292, 742 F.2d 629, 639 (D.C. Cir. 1984). Courts must also defer to an agency's interpretation of its own regulations unless plainly wrong. *General Carbon Co. v. OSHRC*, 273 U.S. App. D.C. 394, 860 F.2d 479, 483 (D.C. Cir. 1998).

ANALYSIS

Petitioner challenges the decision by the USPTO to grant her limited recognition and deny her full recognition as a patent attorney. Petitioner makes three arguments for overturning that decision: (1) it is inconsistent with USPTO regulations; (2) the USPTO regulations exceed the authority of their enabling statute; and (3) the decision is a violation of equal protection. Petitioner's arguments are all based on the premise that the OED Director's decision to grant her limited recognition was based upon her citizenship or residency. Defendant counters that the decision of OED was not based upon the citizenship or residency of petitioner, but rather on the work restrictions imposed on her by INS. As such, defendant argues that its decision to limit recognition of petitioner to the degree of her INS work restrictions is

consistent with the USPTO regulations and those regulations are lawfully authorized by statute. Defendant also argues it has not treated petitioner differently from similarly situated individuals and thus has not denied her equal protection.

A. OED Finding

Before considering the parties' arguments for summary judgment, it is useful to review the basis for the OED Director's decision to restrict petitioner's recognition. Petitioner claims that she was denied full recognition by USPTO because of her citizenship or residency. *See* Pet. Mot. S.J. at 2. Defendant counters that petitioner was granted limited recognition because of the work restrictions imposed by her visa. Defendant directs the Court to numerous citations in the record in support of its assertion, while petitioner fails to cite any evidence beyond her own allegations regarding the basis for her limited recognition. A review of the record shows sufficient evidence that the OED Director granted petitioner limited recognition because of the work restrictions imposed upon petitioner by her visa, rather than simply based upon petitioner's citizenship. *See* Defendant's Notice of Filing of Administrative Record ("Admin. Rec.") Ex. 3 at 4-7, Ex. 9, Ex. 11 at 6-9. Therefore, the Court will assess the parties' arguments for summary judgment in light of the finding that petitioner was granted limited recognition by the OED Director because of the work restrictions imposed upon petitioner by her visa status.

B. OED Decision and USPTO Regulations

Petitioner's first argument is that the OED Director's decision to grant limited recognition is inconsistent with the USPTO regulations governing the recognition of patent attorneys and hence an abuse of the Director's discretion.

Specifically, petitioner makes three broad arguments for overturning the OED Director's decision: (1) the Director did not have discretion to deny her full recognition when she met the requirements of 37 C.F.R. § 10.6; (2) if the Director did have discretion, he abused it; and (3) the Director's decision was inconsistent with the USPTO regulations. Defendant counters that the OED Director has broad discretion in regulating recognition of patent attorneys, and that the limited recognition granted to petitioner is consistent with the governing regulation and the USPTO's interpretation of those regulations and is supported by the record.

To begin with, it is important to note that the OED Director determines who is qualified to practice before the USPTO. *See Maresca v. Commissioner of Patents and Trademarks*, 871 F.Supp. 504, 507 (D.D.C. 1994); *see also* 35 U.S.C. § 2(b)(2)(D) (the USPTO "may establish regulations, not inconsistent with law, which . . . may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office"); 37 C.F.R. § 10.2. Furthermore, the OED Director's decision not to grant recognition to an applicant may be disturbed only if the court finds that the Director abused his discretion. *See Premysler*, 71 F.3d at 389. An abuse of direction occurs if the decision is arbitrary and capricious, based upon the record before the USPTO. *See Maresca*, 871 F.Supp. at 507.

In the instant case, the USPTO concluded that petitioner should be granted limited recognition under § 10.9, rather than full recognition under § 10.6(a). *See* Admin. Rec. Ex. 3 at 5. In doing so, the Director found that granting full recognition would be inconsistent with the work restrictions imposed upon petitioner by her TN (or H-1B) visa. *Id.* Petitioner, by the terms of her visa, is permitted to work for

a single employer, the White & Case law firm, for a limited duration of time. *Id.* Full recognition as a patent attorney would not contain similar restrictions. *Id.* Therefore, the OED Director concluded that granting full recognition under § 10.6(a) would permit the petitioner to perform work before the USPTO that she could otherwise not lawfully do under the terms of her visa. *Id.* The USPTO also based its decision upon the General Requirements Bulletin dated November 3, 1999, which stated that aliens with work restrictions on a visa should only receive recognition by the USPTO to the extent authorized by INS. *Id.* at 6.

Petitioner contends that because she met the qualifications in 37 C.F.R. § 10.6 she must be granted full recognition. *See* Pet. Mot. at 2. Specifically, petitioner applied, passed the exam, is a member in good standing of the bars of New York and Massachusetts, lives in the United States, and satisfies the good moral character requirements. *Id.* at 2. However, petitioner's argument fails to appreciate the discretion granted the OED Director to determine the recognition of patent attorneys. *See Maresca*, 871 F.Supp. at 507. In addition, petitioner neglects the language of § 10.6(a), which states that an individual "may be registered," and, when addressing the issue of registering aliens, states that registration should occur "when appropriate." This language clearly indicates some level of discretion by the USPTO in the granting of recognition to patent attorneys. Petitioner's argument to the contrary is without merit.

The next issue raised by petitioner is whether the OED Director's decision was arbitrary and capricious. The USPTO granted limited recognition to petitioner because of the work restrictions that were imposed by the INS. Specifically, the USPTO's decision was based upon the language of § 10.6(a) which states that an alien can receive recognition if it is not

"inconsistent with the terms upon which the alien was admitted to, and resides in the United States. . . ." Petitioner has not challenged the facts that she is an alien and is limited in the United States to the practice of law for clients of White & Case. Petitioner also does not challenge that these restrictions were imposed by the INS, nor does she contest the validity of the restrictions themselves. The USPTO granted limited recognition only to the extent of those INS restrictions, and petitioner is therefore not further constrained in her ability to engage in the practice of the law. *See* Admin. Rec. Ex. 2 at 1. In fact, petitioner seeks recognition by USPTO for legal activity beyond what she would otherwise be legally permitted to do by the INS. Applying the USPTO's regulations to these facts, the decision of the OED Director to limit recognition is not arbitrary and capricious and is well supported by the record.

Finally, petitioner argues that the OED Director's decision was inconsistent with the USPTO regulations, but this argument also fails. The decision to grant petitioner limited recognition mirrors the USPTO's own interpretation of its regulations embodied in the General Requirements Bulletin dated November 3, 1999. According to that Bulletin, "aliens will be given limited recognition under 37 C.F.R. § 10.9(b) if recognition is consistent with the capacity of employment authorized by the INS." Far from being inconsistent, the OED Director's decision in petitioner's case followed exactly the USPTO's interpretation of its own regulations. This Court must also defer to that interpretation unless it is plainly wrong. *See General Carbon Co.*, 860 F.2d at 483; *Thomas Jefferson Univ. v. Shalala*, 512 U.S. 504, 512, 114 S. Ct. 2381, 129 L. Ed. 2d 405 (1994). Plainly, that interpretation is not wrong as it is a reasonable interpretation of the regulations. The USPTO regulations state that aliens should not be registered if it is "inconsistent with the terms upon

which the alien continues to reside in the United States. . . ." 37 C.F.R. § 10.6(a). The OED Director's decision to give limited recognition to petitioner is consistent with both the language and USPTO's own interpretation of the regulations.

C. Statutory Authority for Limited Recognition

Petitioner next argues that if the USPTO regulations permit limited recognition premised upon INS work restrictions, those regulations exceed their statutory authority. Petitioner observes that the authorizing statute, 35 U.S.C. § 2(b), does not specifically allow the USPTO to enforce INS restrictions. Defendant counters that the USPTO has been granted broad authority to regulate the conduct of those who appear before it, including granting limited recognition based upon INS work restrictions where necessary.

Under 35 U.S.C. § 2, the USPTO is charged with establishing regulations that "govern the conduct of proceedings in the Office," and "govern the recognition and conduct of agents, [and] attorneys. . . ." Because the USPTO is specifically charged with administering the statute, the Court analyzes a challenge to the statutory authority of the regulations under the *Chevron* framework. *See United States v. Mead Corp.*, 533 U.S. 218, 121 S. Ct. 2164, 150 L. Ed. 2d 292 (2001); *Chevron U.S.A. Inc. v. Natural Resources Defense Council*, 467 U.S. 837, 104 S. Ct. 2778, 81 L. Ed. 2d 694 (1984). In conducting that analysis, the Court must first determine whether the statute speaks to the specific issues, and if it is silent or ambiguous, the Court must then defer to the agency's reasonable interpretation. *See Chevron*, 467 U.S. at 842-43.

The statute in this case is silent on the issue whether the USPTO may grant limited recognition for applicants who

have work restrictions imposed by their visas. Instead, the statute grants the USPTO broad authority to regulate the appearance of individuals before that body. First in § 2(b)(2)(A), the USPTO is empowered to "govern the conduct of proceedings in the Office." In addition, § 2(b)(2)(D) empowers USPTO to

> establish regulations, not inconsistent with law, which . . . (D) may govern the recognition . . . of . . . attorneys . . . representing applicants of other parties before the Office, and may require them . . . to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

Defendant argues that this statutory language provides discretion to the USPTO to place restrictions upon the recognition of attorneys who appear before it. Specifically in this case, USPTO argues that the phrase "necessary qualifications" to render "valuable service" provides discretion and permits restrictions in the recognition of aliens who have work-related limitations imposed by the INS. Petitioner argues that the statute does not permit USPTO to enforce INS visa restrictions and that limited recognition is not rationally related to the statutory language in § 2(b)(2)(D).

Petitioner's argument on this issue falls short. An examination of the language of 35 U.S.C. § 2 confirms that the USPTO was given considerable discretion in the regulation of individuals appearing before it. Besides the broad principles of a "good moral character" and "necessary qualifications," the statute gives the USPTO the authority to

"govern the conduct of proceedings in the Office." 35 U.S.C. § 2(b)(2)(A). Furthermore, it is a reasonable interpretation of these broad governing principles for the USPTO to limit recognition of aliens to the extent of their visa imposed work restrictions. It is also rational not to grant full recognition if it entails permitting an individual to conduct work that is beyond what he or she is otherwise legally permitted to do. Therefore, applying the *Chevron* deferential standard, the USPTO did not exceed its statutory authority in promulgating regulations that permit limited recognition of aliens who have work restrictions on their visas.

D. Equal Protection

Petitioner's final argument is that the USPTO's decision violates equal protection.[2] Petitioner's equal protection claim is governed by the minimum rationality standard. *See e.g. Williamson v. Lee Optical of Oklahoma*, 348 U.S. 483, 488, 75 S. Ct. 461, 99 L. Ed. 563 (1955); *see also Mathews v. Diaz*, 426 U.S. 67, 78, 96 S. Ct. 1883, 48 L. Ed. 2d 478 (1976) (upholding different treatment of aliens and citizens) For petitioner to succeed on this claim, she would have to show that she is being treated differently than others who are similarly situated. *See City of Cleburne v. Cleburne Living Center, Inc.*, 473 U.S. 432, 439, 105 S. Ct. 3249, 87 L. Ed. 2d 313 (1985). Once that is shown, it is up to defendant to

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[2] Seemingly in support of petitioner's equal protection argument, she points to *Frazier v. Heebe*, 482 U.S. 641, 107 S. Ct. 2607, 96 L. Ed. 2d 557 (1987), in which the Supreme Court struck down a residency requirement for legal practice as "unnecessary and irrational." However, that decision rested upon the inherent supervisory powers of the lower courts, not the Constitution, and was based upon residency restrictions, which are not the basis of the decision here.

show that the distinction is rationally related to a legitimate government distinction. *See Mathews*, 426 U.S. at 78.

Petitioner argues that she is being treated differently from other similarly situated individuals because, although she has met the requirements of 37 C.F.R. § 10.6(a), she is being denied full recognition. However, petitioner is not similarly situated simply because those other individuals may have met the requirements of 37 C.F.R. § 10.6(a). Instead, the equal protection analysis must consider whether petitioner is being treated differently from other individuals who have similar work restrictions. In this regard, petitioner has made no showing whatsoever that she is being treated differently.

Regardless of petitioner's showing of differing treatment, the USPTO has put forth rational reasons for treating individuals who have work restrictions differently from those that do not. If petitioner were granted full recognition, she would be authorized by the USPTO to engage in the practice of law beyond that which she can otherwise lawfully do under her visa restrictions. The limited recognition granted petitioner in no way constricts her ability fully to represent applicants in accordance with her visa restrictions. Accordingly, under the rationality test, and for the reasons set forth by the USPTO, petitioner has not established that the OED Director's decision denied her equal protection of the law.

CONCLUSION

The decision of the OED Director to grant petitioner limited, rather than full, recognition was consistent with the USPTO regulations and fully supported by the record. Moreover, the USPTO regulations do not exceed the statutory authority, nor did the USPTO deny petitioner equal

protection. Therefore, petitioner's motion for summary judgment will denied and defendant's motion for summary judgment will be granted. A separate order will be issued herewith.

/s/ John D. Bates
JOHN D. BATES
United States District Judge

APPENDIX E

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE UNDER SECRETARY OF COMMERCE OF INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

[Filed May 9, 2003]

In re Catherine Lacavera	Decision on Petition Under 37 C.F.R. § 10.2(c)

MEMORANDUM AND ORDER

Catherine Lacavera (Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED) disapproving Petitioner's petition for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases. The OED Director disapproved Petitioner's petition to be registered as a patent attorney under 37 CFR §10.6(a) because she is a nonimmigrant alien temporarily residing in the United States limited by the terms of her visa to work for one specific law firm only for a limited period of time. Rather than granting Petitioner full recognition, the OED Director granted Petitioner limited recognition under 37 §10.9(b). For the reasons stated below, the OED Director's decision is AFFIRMED.

I. BACKGROUND AND PROCEDURAL HISTORY

Petitioner is a citizen of Canada. Petitioner resides in New York and is authorized by the Immigration and Naturalization Service (INS) to work as a professional pursuant to the North American Free Trade Agreement. By the terms of her visa, known as a TN visa, Petitioner is permitted to work only at the New York office of White & Case preparing and prosecuting patent applications. Petitioner's TN visa is limited in duration. Her TN visa was set to expire August 9, 2002, but has been extended until July 7, 2003. Petitioner may request further extensions of up to one year each, but there is no limit to the number of extensions that she may be granted.

On January 3, 2002, OED received Petitioner's application to take the examination. By letter dated February 20, 2002, OED informed petitioner that her application to take the examination to practice before the USPTO has been approved. In this letter, OED informed Petitioner that because she is a nonimmigrant alien with a limited right to work in the United States, if she were to take and pass the exam, she would not be registered as a patent attorney or agent, but rather, would be eligible for limited recognition under §10.9(b). Petitioner took the exam on April 17, 2002. By letter dated June 3, 2002, OED notified Petitioner that she had passed the exam, but that further documentation was necessary to determine whether to grant her limited recognition. Petitioner provided the requested documentation in a June 17, 2002, letter. In that letter, Petitioner also petitioned pursuant to 37 CFR § 10.170 for a suspension of § 10.9(b) and requested full recognition under § 10.6(a).

On July 8, 2002, OED issued a decision denying the petition. The OED Director noted that recognition of a resident alien under § 10.6(a) must not be inconsistent with

the terms under which the alien entered and resides in the United States. The OED Director concluded that granting Petitioner full recognition under § 10.6(a) would be inconsistent with the terms of her visa. Full recognition, according to the OED Director, provided a license to practice before the USPTO unrestricted in terms of for whom the practitioner may work or when. The OED Director reasoned that such an unrestricted license conflicts with Petitioner's visa which restricts her to working for one firm for a limited period of time.[1]

On August 6, 2002, Petitioner filed a petition for review of the OED Director's decision under 37 CFR § 10.2(c).

II. LEGAL STANDARD

Title 35 U.S.C. § 2(b)(2)(D) states in pertinent part that the USPTO "may establish regulations, not inconsistent with law, which . . . may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office . . . ."

37 CFR § 10.6(a), which implements the statute above, states in pertinent part:

> [w]hen appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, provided:

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[1] The OED Director also concluded that Petitioner is ineligible for limited recognition of foreigners under 37 CFR § 10.6(c), but Petitioner does not raise this issue in her Petition or seek the limited recognition authorized by § 10.6(c).

> Registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further provided: The alien may remain registered only (1) if the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or (2) if the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 10.9(b).

37 CFR § 10.9(b), to which 10.6(a) refers, states that "[w]hen registration of a resident alien under paragraphs (a) or (b) of § 10.6 is not appropriate, the resident alien may be given limited recognition as may be appropriate under paragraph (a) of this section."

The USPTO's November 3, 1999, General Requirements Bulletin addresses recognition of aliens and states that "[q]ualifying nonimmigrant aliens within the scope of 8 CFR § 274a.12(b) or (c) are not registered upon passing the examination. Such aliens will be given limited recognition under 37 CFR § 10.9(b) if recognition is consistent with the capacity of employment authorized by the INS."

Pursuant to 37 CFR § 10.2(c), the OED Director's decision is reviewed based upon the record in this matter.

III. OPINION

A. Issues

Petitioner argues that she meets the requirements for full recognition under § 10.6(a). Petitioner argues that the OED Director improperly read a requirement of permanent

residency and unrestricted employment opportunity into § 10.6(a). Petitioner reasons that since § 10.6(a) states that an alien may remain registered only "if the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States," the regulation anticipates that full recognition can be granted despite the time and employment restrictions imposed by her TN visa. According to Petitioner, until she seeks other employment or fails to renew her TN visa, full recognition is not inconsistent with her visa. Petitioner also argues that the residency requirement she alleges the OED Director to have established is unnecessary and irrational under *Frazier v. Heebe*, 482 U.S. 641 (1987), and the denial of full recognition because of her alien status denies her equal protection guaranteed by the Fifth and Fourteenth Amendments to the United States Constitution.

B. Discussion

The OED Director properly concluded that Petitioner should not be granted full recognition under § 10.6(a). Petitioner's argument that the OED Director improperly read a requirement of permanent residency and unrestricted employment opportunity into § 10.6(a) is unpersuasive. Section 10.6(a) permits registration of an alien only if registration is not inconsistent with the terms upon which the alien was admitted to and resides in the United States. The OED Director properly concluded that granting Petitioner full recognition would be inconsistent with the terms of her TN visa. That visa limits Petitioner to working for a single employer, and is limited in duration, but recognition under § 10.6(a) would have no similar restrictions. With full recognition under § 10.6(a), Petitioner would be authorized to represent any party before the USPTO with no set ending

date. Recognition under § 10.6(a) would provide Petitioner with USPTO approval of work than she cannot lawfully do under her TN visa, making that recognition inconsistent with the terms of her visa.

The fact that Petitioner's visa already contains restrictions and that the INS may take action against Petitioner for violations of those restrictions does not mean that the OED Director should ignore them in deciding whether to grant recognition. If the OED Director were to grant Petitioner recognition under § 10.6(a) and she subsequently were to represent someone other than a White & Case client, or represent a White & Case client after failing to extend her visa, Petitioner would violate her visa, but not the terms of her recognition. The authority granted to the OED Director to afford limited recognition under § 10.9(b) is well tailored to prevent this result.

At its core, recognition before the USPTO is recognition to represent applicants or other parties before the USPTO. Unlimited recognition, which in no way limits the applicants or parties the registrant may represent, is not consistent with Petitioner's visa. Petitioner focuses on the restrictions contained in her visa as sufficient protection against unlawful representation before the USPTO. In granting recognition, however, the OED Director is not looking for guarantees from other sources that the work Petitioner will do before the USPTO is proper. The OED Director must assure that the terms of the recognition itself provide the guarantee. In this case, full recognition devoid of explicit limitation would not provide that guarantee and would be inconsistent with the terms of Petitioner's visa.

The OED Director did not read any improper requirements into § 10.6(a) as Petitioner argues, but was

consistent with the USPTO's interpretation of how § 10.6(a) is applied to nonimmigrant aliens. The General Requirements Bulletin provides interpretive rules construing, *inter alia*, the regulations contained in 37 CFR §§ 10.5, 10.6, and 10.7. *See Premysler v. Lehman*, 71 F.3d 387 (Fed. Cir. 1995). The General Requirements Bulletin states that "[q]ualifying nonimmigrant aliens within the scope of 8 CFR § 274a.12(b) or (c) are not registered upon passing the examination. Such aliens will be given limited recognition under 37 CFR § 10.9(b) if recognition is consistent with the capacity of employment authorized by the INS." Petitioner is a nonimmigrant alien within the scope of 8 CFR § 274.12(b)(19). In fact, Petitioner was told in the February 20, 2002, notice of admission to take the April 17, 2002, examination that her status as a nonimmigrant alien would preclude her from full recognition even if she passed the exam. The OED Director's decision was consistent with this notice and with the USPTO's longstanding interpretation of how § 10.6(a) is applied to nonimmigrant aliens.

Petitioner argues that "the availability of limited recognition status is not a reasonable alternative because it prevents Petitioner from holding herself out and practicing on the same terms as a registered patent attorney," but that is precisely the point behind the limited recognition. Petitioner cannot hold herself out on the same terms as a registered patent attorney because of the restrictions imposed by her TN visa. If she were given full recognition, Petitioner could hold out that her registration is the same as any other registered patent attorney, as her argument suggests she wishes to do, even though her TN visa would prohibit her from working as any other patent attorney works. The USPTO has a legitimate interest in ensuring that it does not provide Petitioner with the cover to hold herself out as something she truly is not.

Petitioner cites *Frazier v. Heebe*, 482 U.S. 641 (1987), for support of her position that the OED Director's decision is irrational. In *Frazier*, the Supreme Court invalidated a local rule of the U.S. District Court for the Eastern District of Louisiana that required members of its bar either to reside in Louisiana or maintain an office in Louisiana. *Id.* at 643. The Court concluded that her residency requirement was unnecessary and irrational because there was no reason to believe that resident attorneys are any more competent that non-resident attorneys, or that non-resident attorneys are any less available to participate actively in a case than a resident attorney. *Id.* at 646-49. The Court also found the in-state office requirement unnecessary and irrational for the same reasons as well, with the additional reason that the requirement is not imposed on attorneys who reside in Louisiana and whose only office is out of state. *Id.* at 649-50.

The *Frazier* decision does not lend any support to Petitioner's case for two reasons. First, the Court's decision was based upon its inherent supervisory power of the lower courts, and not any Constitutional, statutory, or regulatory provision that would apply to the USPTO. Second, unlike in *Frazier*, there is a rational and necessary basis to distinguish between Petitioner and other attorneys. Petitioner's availability to perform legal work is strictly limited by the terms of her visa. Other attorneys who receive full recognition do not have such limitations. While in *Frazier* the Court found no reason to doubt the ability of Frazier vis-à-vis other attorneys who reside in Louisiana or have an office there, here there is an undisputed difference in the availability of Petitioner to perform legal services compared to other practitioners.

Finally, Petitioner claims that the OED Director's decision denies her equal protection guaranteed by the Fifth and

Fourteenth Amendments to the United States Constitution. Petitioner's arguments here are also unpersuasive. Petitioner's equal protection claim fails first because she has not shown that she is being treated differently than another to whom she is similarly situated. *See City of Cleburne v. Cleburne Living Center, Inc.*, 473 U.S. 432, 439 (1985) (explaining that the Equal Protection Clause is essentially a direction that all persons similarly situated should be treated alike.) Petitioner has not shown that the OED Director has granted full recognition under § 10.6(a) to individuals with similar restrictions on their ability to work as those placed on Petitioner. Because she is not being treated differently than others like her, Petitioner has not been denied equal protection. Furthermore, the Supreme Court has recognized that "a legitimate distinction between citizens and aliens may justify attributes and benefits for one class not accorded the other." *Matthews v. Diaz*, 426 U.S. 67, 78 (1976).

Petitioner's equal protection claim also fails because the OED Director's decision is supported by a rational basis. Even if Petitioner could show she is being treated differently from similarly situated applicants for registration, the OED Director's decision need only pass a rational basis standard. *Matthews*, 426 U.S. at 83. As discusses above, the OED Director's decision is based upon the rational distinction between Petitioner, whose employment opportunities are restricted, and those whose opportunities are not so restricted. It is eminently rational for the OED Director to decide to grant Petitioner a form of limited recognition which mirrors her visa, and Petitioner has not shown otherwise. Accordingly, Petitioner has not established that the OED Director's decision denies her equal protection.

IV. CONCLUSION

For the reasons stated above, the OED Director's decision is in accord with the governing regulations and well-based on the evidence in the record. The OED Director's decision is hereby affirmed.

ORDER

Upon consideration of the Petition to the USPTO Director for registration to practice before the USPTO in patent cases under 37 CRF § 10.6(a), it is ORDERED that the petition is denied.

On behalf of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

/s/ James Toupin
James Toupin
General Counsel
United States Patent and Trademark Office

May 9, 2003

APPENDIX F

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
OFFICE OF ENROLLMENT AND DISCIPLINE

[Filed July 8, 2002]

In re Application of:	)
	)
Catherine Lacavera	)
White & Case	)
1155 Avenue of Americas	)
New York, New York 10036-2787	)
	)

DECISION ON PETITION UNDER 37 CFR § 10.170

Consideration has been given to Catherine Lacavera's (Petitioner's) letter dated June 17, 2002. The letter was received in OED on June 20, 2002, and is responsive to an OED letter dated June 3, 2002, which informed Petitioner, who is a citizen of Canada, that she had passed the registration examination and that further information was needed to determine her eligibility for the grant of limited recognition pursuant to 37 CFR § 10.9(b). Petitioner's letter is treated as being as a Petitioner under 37 CFR § 10.170 to suspend the requirements of § 10.9(b), and to grant Petitioner the full status as a registered practitioner. After careful review of Petitioner's petition and arguments, Petitioner's petition is DENIED for the reasons set forth below.

BACKGROUND

The Director of the United States Patent and Trademark office (USPTO) is given statutory authority to prescribe regulations governing recognition and conduct of persons representing parties before the USPTO and to require a showing by patent practitioners that they are "possessed of the necessary qualifications to render applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office." 35 U.S.C. §2(b)(2)(D).

Pursuant to that responsibility, USPTO regulations provide that an individual who is an alien will be registered to practice before the USPTO provided he or she lawfully resides in the United States and registration is not inconsistent with the terms upon which the alien continues to lawfully reside in the United States; or if the alien ceases to reside in the United States, the alien is qualified to be registered under 37 CFR § 10.6(c). *See* 37 CFR § 10.7(a) and (b). The General Requirements Bulletin sets forth policies for complying with the provisions of 37 CFR § 10.6. *Premysler v. Lehman*, 71 F.3d 387, 390 (Fed. Cir. 1995) ("The Commissioner promulgated the General Requirements bulletin to interpret [37 CFR § 10.6(a), (b) and (c)].")

As provided by 37 CFR § 10.170:

> In an extraordinary situation, when justice requires, any requirement of the regulations of this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee . . . on petition of any party . . .

(emphasis added). The Manual of Patent Examining Procedure (MPEP) notes that "[p]etitions to suspend the rules under 37 CFR § 10.170 are delegated to the Director of Enrollment and Discipline. *MPEP 1002.02.* However, "[a]ny final decision of the Director refusing to register an individual [to practice before the Office] . . . may be reviewed by petition to the Director [of the USPTO] upon payment of the fee set forth in [37 CFR] § 1.21 (a)(5)." 37 CFR § 10.2(c).

Petitioner applied to take the registration examination by application received on January 3, 2002. Petitioner has been admitted to the New York and Massachusetts state bars. Petitioner is a citizen of Canada who is temporarily residing in the United States on TN status, which will expire on August 9, 2002. Petitioner has demonstrated that she is authorized to be employed only by the law firm of White and Case while on TN status.

A Notice of Admission to the April 17, 2002 Examination was mailed February 20, 2002, explaining to Petitioner that she would be admitted to the registration examination, but that, should she take and pass the examination, she would not be registered. Specifically, Petitioner was advised prior to taking the examination:

> As long as you remain in the United States on a visa limiting your employment to a specific employer and period of time, e.g. TN status, you are precluded by the terms of the visa under 8 U.S.C. § 1101(a)(15) from being registered under §§ 10.6(a) or 10.6(b).

By letter dated June 3, 2002, Petitioner was informed that she passed the April 17, 2002, examination for registration to practice in patent cases before the PTO. Petitioner was not given limited recognition status because of the approaching

expiration date of her visa, August 9, 2002, but was informed in the letter dated June 3, 2002, that "further information . . . is required before OED will make a decision whether to grant you limited recognition under 37 CFR § 10.9(b)."

Instead of seeking *limited* recognition as postulated by the June 3rd letter, Petitioner now seeks *full* registration status. In support thereof, Petitioner cites *Frazier v. Heebe*, 482 U.S. 641 (1987) as holding that "residency requirements for legal practice are typically 'unnecessary and irrational.'" Petitioner also contents that "37 CFR § 10.9,[1] which limits temporary residents to limited recognition status, may contravene the Equal Protection clause of Amendment XIV of the United States Constitution."

Petitioner asserts that since all business is required to be transacted in writing, residence is irrelevant. Petitioner cites no legal authority under NAFTA for affording Canadians full recognition to practice, but in essence argues that Canadians temporarily present in the United States should be treated no differently than American citizens under the Equal Protection clause.

In a separate communication, Petitioner has been granted limited recognition under 37 CFR § 10.9(b). The limited recognition will expire on August 9, 2002, when Petitioner's present TN status expires. Petitioner intends to renew her TN status, and OED looks forward to receiving evidence of the same.

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[1] Presumably, Petitioner is addressing only 37 CFR § 10.9(b). Unlike section 10.9(b), sections 10.9(a) and (c) do not reference resident aliens.

Petitioner has not demonstrated that she is registered in good standing to practice before the Canadian Patent Office.

DISCUSSION

Registration as a patent attorney under 37 CFR § 10.6(a) or as a patent agent under 37 CFR §10.6(b) is provided for citizens of the Untied States and aliens lawfully residing in the United States upon a showing that registration is not inconsistent with the terms upon which the alien was admitted to and resides in the United States and only for so long as the alien continues to reside in the United States.

Petitioner is a citizen of Canada, is a resident of the United States, and does not appear to be registered before the patent office of any other country. Registration qualifications under 37 CFR § 10.6(c) require both registration before the Canadian Patent Office and residence in Canada[2]. Accordingly, Petitioner currently is and would be ineligible for registration under § 10.6(c) upon returning to Canada. Further, Canadian patent agents registered under § 10.6(c) can represent only "applicants located in Canada." Persons registered under § 10.6(a) or (b) are not limited to representing "applicants located in Canada." Still further, registration at the Canadian Patent Office as a patent agent

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[2] Under 37 CFR §10.6(c) a Canadian filing satisfactory proof that he or she is registered and in good standing before the Canadian Patent Office, that he or she resides and practices in Canada, and is possessed of the qualifications stated in § 10.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, provided the Canadian Patent Office allows substantially reciprocal privileges to those admitted to practice before the USPTO.

would not provide Petitioner with the ability to be registered while residing in the United States with a TN status. *See* § 10.6(a) and (b).

The status of aliens within the United States is determined by the Immigration and Naturalization Service (INS). *See* 8 CFR §§ 214.1 and 214.2. In order to reside in the United States legally, each arriving nonimmigrant alien must maintain "a valid unexpired visa and an unexpired passport, valid for the period set forth in section 212(a)(26) of the Act." *See* 8 CFR § 212.1.

According to federal immigration law, only immigrant aliens and nonimmigrant aliens with special permission are entitled to work. The Attorney General has authority to regulate not only the admission of aliens, but also the conduct of aliens who are in the United States. *See, e.g., Narenji v. Civiletti*, 199 U.S. App. D.C. 163, 617 F.2d 745, 747 (D.C. Cir.). Aliens in the United States acquire only the "limited status" established by the regulations and statutes, and they have no constitutional right to work without authorization. *Pilapil v. INS*, 424 F.2d 6, 11 (10th Cir.), *cert. den.* 400 U.S. 908, 27 L. Ed. 2d 147, 91 S.Ct. 152 (1970) (deportation of a nonimmigrant F-1 student who failed to comply with conditions of his status by having been employed without permission held constitutional). *Accord, Aliens For Better Immigration Laws v. U.S.*, 871 F. Supp. 182 (S.D.N.Y. 1994) (aliens seeking permission to work legally in the U.S. between the time they obtain labor certification and the time they receive their visas were found to have "no constitutional right to work without authorization," citing *WJA Realty Limited Partnership v. Nelson*, 708 F. Supp. 1268, 1273 (S.D. Fla. 1989); and *Pilapil v. INS, supra.*

Petitioner has been granted entry into the United States under TN status. Therefore, for purposes of this Petition and application Petitioner is considered a nonimmigrant alien when she is in the United States.

There are several reasons why registration § 10.6(a) or (b) is inconsistent with Petitioner's TN status. Registration is not limited in time, or to a particular employer, or to conditions imposed by the INS. Registered practitioners, subject to a violation of the Disciplinary Rules, essentially have a lifetime license to practice patent law before the USPTO, without any residency restrictions. The employment authorization of the TN status is inconsistent with the lifetime registration status in several ways. Petitioner has been granted permission to stay in the United States for only limited period of time, cannot be self-employed, and is prohibited from changing or acquiring new employers without first obtaining the consent of the INS. *See* 8 CFR §214.6(i)(2).

Specifically, according to 8 CFR § 214.6, persons having TN status are approved as a businessperson for temporary entry. According to 8 CFR § 214.6(a), a citizen of Canada seeking temporary entry as a businessperson to engage in business activities at a professional level may be admitted to the United States in accordance with the North American Free Trade Agreement (NAFTA). The phrase "engage in business activities at a professional level" is defined in 8 CFR § 214.6(b) as:

> the performance of prearranged business activities for a United States entity, including an individual. It does not authorize the establishment of a business or practice in the United States in which the professional will be, in substance, self-employed. A professional will be deemed to be self-employed if he or she will

> be rendering services to a corporation or entity of which the professional is the sole or controlling shareholder or owner.

Persons having TN status are prohibited from being self-employed. Also, persons having TN status are approved only for temporary entry. As stated in 8 CFR § 214.6(b):

> Temporary entry, as defined in the NAFTA, means entry without the intent to establish permanent residence. The alien must satisfy the inspecting immigration officer that the proposed stay is temporary. A temporary period has a reasonable, finite end that does not equate to permanent residence. In order to establish that the alien's entry will be temporary, the alien must demonstrate to the satisfaction of the inspecting immigration officer that his or her work assignment in the United States will end at the predictable time and that he or she will depart upon completion of the assignment.

The maximum approval period for TN status is one year. *See* 8 CFR § 214.6(f). After one year, one-year extensions may be sought. *See* 8 CFR § 214.6(h). Although there is no specific limit on the total period of time a citizen of Canada may remain in TN status, extensions are available only in one year increments. *Id.* The record does not demonstrate that Petitioner acquired the right to be registered or otherwise recognized to practice before the Office by virtue of receiving TN status.

Unlike a citizen or permanent resident of the United States, a non-immigrant with TN status obtains employment authorization only to work for a specific employer and only in maximum increments of one year. In Petitioner's case, she

is entitled to work only until August 9, 2002, for the law firm of White and Case. On or before August 9, 2002, Petitioner must leave the country or obtain an extension. *See* 8 CFR § 214.2(h). Registration would be inconsistent with the terms of the TN status. Registration, once granted, is afforded for the practitioner until such time as the practitioner resigns or registration is revoked or suspended for misconduct in accordance with the procedures of 35 U.S.C. § 32.

Registration would permit Petitioner to accept employment from any other employer other than the employer for whom she was admitted to work without obtaining authorization form the INS to work for the other employer. It would be inconsistent with 8 CFR § 214.6(i)(2) to permit Petitioner to work for other employers without first obtaining INS authorization. "Employment with a different or additional employer is not authorized prior to Service approval of the petition." *Id.*

Registration would permit Petitioner to have her own client, and be, in effect, self-employed. However, pursuant to 8 CFR § 214.6(b) Petitioner's TN status does not permitted her to be self-employed in the United States.

Registration would permit Petitioner to continue to practice or work in this country after the one-year period of authorized employment expires, and to practice in any foreign country, including Canada. However, absent an extension granted by the INS, Petitioner's TN status does not permit her to be employed in the Untied States after expiration of the one-year increment for which TN status is granted. Further, Petitioner's TN status does not authorize her continued employment in the United States upon her departure from the United States. *See* 8 CFR § 214.6(h)(2). Upon returning to

Canada, Petitioner is not entitled to represent patent applicants based upon having once been granted TN status.

Petitioner acknowledges that the Equal Protection clause prohibits discrimination on the basis of alienage unless the discriminatory provision is at least rationally related to a legitimate government interest. Section 10.9(b) is rationally related to legitimate government interests. Limited recognition is temporary license to practice in patent cases before the Office. It allows a person Petitioner to perform the duties of registered practitioner in a manner consistent with the beneficiary's TN status. Limited recognition is granted in maximum increments of one year and would permit Petitioner to prepare and prosecute U.S. patent applications wherein Petitioner represents clients of the law firm of White & Case, LLP, and wherein a registered practitioner, who is member of the firm, is the attorney or agent of record in the application. Use of temporary licenses is authorized by regulation where they are available and the beneficiary would be allowed to perform the duties of the profession. *See* 8 CFR § 214.6(d)(iv)(B). Limited recognition under § 10.9(b) assures that a beneficiary's license does not extend in duration and employer beyond that authorized by the INS for TN classification. Further, limited recognition is consistent with the prohibition in § 214.6(b) against self-employment by requiring a registered practitioner, who is a member of the firm of the authorized employer, to be the attorney or agent of record. Sill further, limited recognition is consistent with assuring the government's interest of assuring continued ethical representation of the firm's clients after the TN beneficiary is no longer available as a result of returning to Canada or changing employers.

Thus, the practice of granting limited recognition in one-year increments is not unfair or unduly burdensome.

Recognition in maximum increments of one year is consistent with the terms of the TN status, and permits Petitioner to provide professional services to the employer as authorized by the INS. If Petitioner ceases to be employed by White and Case, it is reasonable to provide that recognition end inasmuch as the authorized employment has ended and recognition is no longer consistent with the terms of Petitioner's TN status. Likewise, if Petitioner ceases to reside in the United States, it is reasonable to end recognition to practice before the USPTO.

Petitioner has not cited any legal authority under NAFTA upon which her claim for registration may be based.

Regarding the provisions of 37 CFR § 10.170, the Director of the United States Patent and Trademark Office has interpreted an extraordinary situation as one that is not an "oversight that could have been prevented by the exercise of ordinary care or diligence." *Nitto Chemical Industry Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1781 (D.D.C. 1994). Additionally, an extraordinary circumstance can be defined as a situation where "no meaningful alternatives are available." *Margolis v. Banner*, 599 F.2d 435, 443; 202 USPQ 365, 371 (CCPA 1979). Here, there has been no showing of an extraordinary situation that would warrant suspension or waiver of the requirements set forth in the Disciplinary Rules of the United States Patent and Trademark Office.

The record does not demonstrate that Petitioner acquired a right to be registered or otherwise recognized to practice before the Office by virtue of having TN status.

Petitioner's reliance on the decision of *Frazier v. Heebe*, 482 U.S. 641 (1987), is misplaced. In *Frazier*, the United States Supreme Court found no rational basis for the denial of

admission to the Bar of the United States District Court for the Eastern District of Louisiana because that petitioner, Frazier, a United States citizen and an attorney, neither lived nor had an office in Louisiana, although that petitioner was admitted to practice in Louisiana and Mississippi, and "had his law office in Pascagoula, Mississippi." The Supreme Court held that "[a] district court was not empowered to adopt Rules requiring members of the Louisiana Bar who apply for admission to its bar to live, or maintain an office, in Louisiana." *Id.* at 641. Unlike Frazier, Petitioner is not a citizen of the United States, is not authorized to have her own law office and otherwise be self-employed, and is not authorized to indefinitely work at will in the United States.

Though business is conducted in wiring with the USPTO, residence is relevant for Petitioner. Upon expiration of her TN status, Petitioner could not merely continue to lawfully reside in the United States and conduct business with the USPTO. Petitioner must either depart the United States or follow procedures established by the INS to either extend the TN status or to lawfully reside and work in United States. If Petitioner returns to Canada, her authority to practice before the USPTO would change. Petitioner has not shown that she acquired a right upon returning to Canada to practice before the Office representing patent applicants from throughout the world. Petitioner has not shown that she is registered to practice before the Canadian Patent Office. Accordingly, upon returning to Canada, Petitioner would not be entitled to be registered under 37 CFR § 10.6(a), (b), or (c) and practice before this Office. Consequently, Petitioner could not communicate with the Office from Canada or otherwise represent patent applicants or others having patent business before the Office. If Petitioner were registered and in good standing with the Canadian Patent Office, Petitioner could be

registered to represent only applicants located in Canada. *See* 37 CFR § 10.6(c).

Petitioner has not shown that an extraordinary circumstance would warrant suspension of the rules. Unless Petitioner has demonstrated an extraordinary situation that warranted waiver of the rules, the petition must be denied. No such demonstration has been made here.

Justice does not require suspension or waiver of the Rules. Petitioner has not shown that there is any reason why [REDACTED] should not be required to meet the requirements that other persons eligible for registration must meet.

DECISION

For the foregoing reasons, Petitioner's petition for registration as a practitioner is hereby DENIED.

APPEAL RIGHTS

This is a final decision by the Director of the Office of Enrollment and Discipline. This is not a final decision of the agency. Petitioner may seek an appeal of this decision by filing a petition to the Director of the United States Patent and Trademark Office pursuant to 37 CFR § 10.2(c) within thirty (30) days after the date on this decision provided below. No new evidence will be considered by the Director of the United States Patent and Trademark Office in deciding the petition for review. Any petition for review should be sent to:

Director of the United States Patent and Trademark Office
Mail Stop OED
United States Patent and Trademark Office

P.O. Box 2327
Washington, D.C. 22202-2327

Any petition for review must include the fee set forth in 37 CFR § 1.21(a)(5).

/s/ Harry I. Moatz
Harry I. Moatz
Director of Enrollment and Discipline

July 8, 2002
Date

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No. 06-338

In the Supreme Court of the United States

CATHERINE LACAVERA, PETITIONER

v.

JONATHAN W. DUDAS, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTIONS PRESENTED

The United States Patent and Trademark Office (PTO) has issued a regulation that authorizes attorneys who are admitted to the United States as temporary residents, with employment restrictions on their visas, to practice before PTO under terms that incorporate those visa restrictions. The questions presented are:

1. Whether that regulation falls within PTO's statutory authority to issue regulations to "govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office." 35 U.S.C. 2(b)(2)(D).

2. Whether that regulation violates the equal protection component of the Due Process Clause.

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In the Supreme Court of the United States

No. 06-338

CATHERINE LACAVERA, PETITIONER

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 3a-9a) is reported at 441 F.3d 1380. The order and memorandum opinion of the district court (Pet. App. 10a-11a, 12a-27a) are unreported.

JURISDICTION

The judgment of the court of appeals was entered on February 6, 2006. A petition for rehearing was denied on June 5, 2006 (Pet. App. 1a-2a). The petition for a writ of certiorari was filed on September 5, 2006. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. Congress has delegated to the United States Patent and Trademark Office (PTO) authority to issue regulations that "govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office." 35 U.S.C. 2(b)(2)(D). Congress has further delegated to PTO authority to require such representatives, before being recognized, "to show that they are of good moral character and reputation and possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office." *Ibid.*

In the exercise of that statutory authority, and pursuant to notice-and-comment rulemaking procedures, PTO has issued regulations establishing standards for attorneys who practice before it. 37 C.F.R. 11.6-11.9. One of those regulations specifies that "[a]ny citizen of the United States who is an attorney and who fulfills [the applicable] requirements * * * may be registered as a patent attorney to practice before the Office." 37 C.F.R. 11.6(a). That same regulation provides that "[w]hen appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills [the applicable] requirements * * * may be registered as a patent attorney to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States."

Another PTO regulation specifies that "[a] nonimmigrant alien residing in the United States and fulfilling [the applicable requirements] * * * may be granted

limited recognition if the nonimmigrant alien is authorized by the Bureau of Citizenship and Immigration Services to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application." 37 C.F.R. 11.9(b). Such "[l]imited recognition shall be granted for a period consistent with the terms of authorized employment or training." *Ibid.* The limited-recognition regulation does not otherwise limit the activities that an attorney may undertake. *Ibid.* Accordingly, apart from compliance with his or her visa requirements, an attorney who practices before PTO under limited recognition practices just like any other recognized practitioner. He or she may prosecute patent applications, hold examiner interviews, and represent applicants before the Board of Patent Appeals and Interferences.

2. a. Petitioner is a citizen of Canada. Pet. App. 5a. In 2001, the Immigration and Naturalization Service (INS) granted her a one-year "TN" visa that allowed her to live in the United States and to prepare and prosecute patent applications only at the New York offices of the law firm of White and Case. *Id.* at 6a. After passing PTO's registration examination, petitioner was granted limited recognition to practice before PTO on terms consistent with her visa status. *Ibid.*

In 2003, after obtaining extensions of her TN visa, petitioner obtained an H-1B visa. Pet. App. 6a. That three-year visa identified a new employer, Google, Inc. Petitioner's sole approved employment under her H-1B visa was the preparation and prosecution of patent applications for Google. *Ibid.* PTO adjusted the terms of petitioner's limited recognition as her visa status changed, allowing her to practice before it to the extent permitted by her new visa. *Ibid.*

b. In July 2002, petitioner initiated administrative proceedings against PTO, seeking authorization to practice before PTO without regard to her visa restrictions. Pet. App. 6a. PTO's Office of Enrollment and Discipline denied petitioner's request for full recognition. *Id.* at 38a-51a. The Office Director explained that petitioner's request was inconsistent with the TN status included in her visa. *Id.* at 44a. In particular, full recognition "is not limited in time, or to a particular employer, or to conditions imposed by the INS," whereas petitioner was authorized "to stay in the United States for only [a] limited period of time, cannot be self-employed, and is prohibited from changing or acquiring new employers without first obtaining the consent of the INS." *Ibid.*

c. The Director of PTO affirmed the Office Director's decision. Pet. App. 28a-37a. The PTO Director concluded that full recognition "would provide petitioner with PTO approval of work tha[t] she cannot lawfully do under her TN visa, making that recognition inconsistent with the terms of her visa." *Id.* at 33a. The PTO Director rejected petitioner's argument that PTO lacked authority to take her visa restrictions into account because the restrictions could be enforced by immigration officials. The PTO Director explained that PTO "is not looking for guarantees from other sources" that practitioners will perform only legally authorized work, but instead "must assure that the terms of the recognition itself provide the guarantee." *Ibid.* The PTO Director added that PTO "has a legitimate interest in ensuring that it does not provide Petitioner with the cover to hold herself out as something she truly is not." *Id.* at 34a.

3. Petitioner sought review of PTO's final decision in the United States District Court for the District of Co-

lumbia. Pet. App. 6a. The district court granted summary judgment for PTO. *Id.* at 12a-27a.

The district court first rejected petitioner's contention that PTO lacked authority under the regulations to deny petitioner full recognition. The court noted that the regulations provide that full recognition may not be granted when it is inconsistent with the terms upon which an alien is admitted into the country. Pet. App. 22a. And it agreed with PTO that granting petitioner full recognition would be inconsistent with the terms of her visa. *Ibid.*

The court also rejected petitioner's contention that PTO lacked statutory authority to deny her full recognition. The court concluded that PTO's full-recognition and limited-recognition regulations fell within PTO's statutory authority to establish regulations that govern the recognition and conduct of attorneys who practice before it. Pet. App. 23a-25a.

Finally, the district court rejected petitioner's equal protection claim. Pet. App. 25a-26a. The court explained that PTO has a rational basis for denying full recognition to petitioner and other persons with work restrictions. In particular, "[i]f petitioner were granted full recognition, she would be authorized by the [PTO] to engage in the practice of law beyond that which she can otherwise lawfully do under her visa restrictions." *Id.* at 26a.

4. The court of appeals affirmed. Pet App. 3a-9a. The court rejected petitioner's contention that PTO abused its discretion under the regulations in denying petitioner full recognition. The court explained that "[b]ecause granting [petitioner] full registration would have given her PTO approval to do work in which she could not lawfully engage, * * * granting her full reg-

istration was inconsistent with the terms of her visa." *Id.* at 8a.

The court of appeals next rejected petitioner's contention that PTO lacked statutory authority to deny petitioner full recognition. Pet. App. 8a. The court explained that PTO has statutory authority to require applicants to demonstrate that they possess the "necessary qualifications," and that "[i]t was reasonable for the PTO to interpret legal authority to render service as being a necessary qualification." *Id.* at 9a.

Finally, the court of appeals rejected petitioner's argument that she had been denied equal protection. The court noted that petitioner had "offered no evidence that she was treated unequally as compared to other aliens with visa restrictions." Pet. App. 9a. Applying rational basis review, the court then concluded that there was a rational basis for denying full recognition to aliens with visa restrictions: "minimizing the unauthorized practice of law before the PTO and its attendant public harm." *Ibid.*

5. On October 4, 2006, after her petition for a writ of certiorari was filed, petitioner advised PTO that she had been granted permanent residency status on September 25, 2006. Letter from Catherine Lacavera, IP Litigation Counsel, Google Inc., to Harry I. Moatz, Director of Enrollment and Discipline, U.S. Patent and Trademark Office. As a permanent resident, petitioner became eligible for full recognition. 37 C.F.R. 11.6(a). On December 11, 2006, PTO granted petitioner full recognition. Letter from Shirley A. Martin, Enrollment Program Specialist, Office of Enrollment and Discipline, U.S. Patent and Trademark Office, to Catherine C. Lacavera (Dec. 15, 2006).

ARGUMENT

The court of appeals' decision upholding PTO's limited-recognition regulation is correct. It does not conflict with any decision of this Court or of any other court of appeals. Moreover, because of petitioner's change in status to a permanent resident, the PTO has granted petitioner the full recognition that she seeks. Review by this Court is therefore not warranted.

1. Petitioner contends (Pet. 10-13) that PTO lacks statutory authority to deny full recognition to an attorney based on the work limitations in her visa. That contention is without merit and does not warrant review.

Congress has given PTO authority to "govern the recognition" and establish the "necessary qualifications" of the professionals who practice before it. 35 U.S.C. 2(b)(2)(D). Pursuant to that authority, PTO has decided that an attorney does not possess the "necessary qualifications" for full recognition when such recognition would allow the attorney to exceed the limitations in the attorney's work visa. In that circumstance, PTO does not exclude the attorney from practicing before the agency. Instead, it affords the attorney limited recognition that allows the attorney to practice before PTO to the extent consistent with the limitations in the attorney's visa.

The facts of this case illustrate how that standard is applied. Petitioner's visa limited her to practicing law for a particular employer for a specified period. Rather than give petitioner full recognition, which would have allowed her to practice before the agency on her own, and for an undefined period, PTO instead gave petitioner limited recognition, which allowed petitioner to practice before it as long as she was performing work in accordance with the limitations in her visa.

Under *Chevron U.S.A. Inc.* v. *NRDC*, 467 U.S. 837, 844 (1984), PTO's approach to implementing its statutory authority must be upheld as long as it is reasonable. That standard was satisfied here. As the court of appeals explained, "it was reasonable for the PTO to interpret legal authority to render service as being a necessary qualification," and "it was reasonable for the PTO to enact regulations that limit an alien's ability to practice before it to those activities in which the alien may lawfully engage." Pet. App. 9a.

Petitioner errs in contending (Pet. 11-12) that PTO's regulation encroaches on the authority of the Department of Homeland Security (DHS) to enforce visa restrictions. When PTO takes into account an attorney's visa restrictions, it neither interprets nor enforces the immigration laws. Rather, PTO accepts DHS's determinations of the attorney's work restrictions. PTO merely conforms the scope of the applicant's recognition to those restrictions.

Moreover, in limiting an attorney's recognition to the activities in which the attorney may lawfully engage, PTO is furthering its own legitimate interests in regulating the practice of attorneys who appear before it. As PTO has explained, "the [PTO] has a legitimate interest in ensuring that it does not provide Petitioner with the cover to hold herself out as something she truly is not." Pet. App. 34a. The court of appeals therefore correctly concluded that, in limiting nonimmigrant-alien attorneys to the activities in which they may lawfully engage, PTO acted within its statutory authority.

2. Petitioner contends (Pet. 13-16) that PTO's limited-recognition rule violates equal protection. That contention is likewise without merit and does not warrant review.

a. There is no merit to petitioner's contention (Pet. 14) that heightened scrutiny applies to PTO's rule limiting nonimmigrant aliens to lawful work activities. Under *Mathews* v. *Diaz*, 426 U.S. 67 (1976), alienage classifications imposed by the federal government are not subject to heightened scrutiny. Instead, such restrictions are reviewed under a standard that is akin to rational basis review. *Id.* at 81-84.

Heightened scrutiny is particularly unwarranted here. PTO's limited recognition of petitioner simply tracks the work limitations on petitioner's visa, and petitioner does not challenge the constitutionality of the visa restrictions. There cannot possibly be anything constitutionally suspect about a rule that limits an attorney to the activities that the attorney may lawfully perform.

Petitioner contends (Pet. 15-16) that heightened scrutiny is required under *Hampton* v. *Mow Sun Wong*, 426 U.S. 88 (1976). In that case, the Court held that a Civil Service Commission regulation that barred all aliens from federal employment violated due process. *Id.* at 116-117. The Court reasoned that the Civil Service Commission's only concern was in "the promotion of an efficient federal service," that "it is fair to assume that its goal would be best served by removing unnecessary restrictions on the eligibility of qualified applicants for employment," and that "administrative convenience" did not provide a sufficient "rational basis" for the rule in light of the "wholesale deprivation of employment opportunities caused by the Commission's indiscriminate policy." *Id.* at 114-116.

That analysis has no application here. The regulation at issue in this case does not create a wholesale deprivation of employment opportunities through an indiscriminate policy aimed at all aliens. Instead, it allows

nonimmigrant aliens to practice before PTO; it simply does so through a tailored policy that limits the attorneys to the activities that they may lawfully perform under their visas. The circumstances that led to the invalidation of the rule in *Hampton* are therefore entirely absent here.

Petitioner also errs in contending (Pet. 16) that the heightened scrutiny question presented in this case is "analogous" to the question presented *Leclerc* v. *Webb*, No. 06-11 (filed June 22, 2006), and *Wallace* v. *Calogero* No. 05-1645 (filed June 23, 2006). The petitions in those cases pose the question presented as whether strict scrutiny applies to a *state law* rule that denies nonimmigrant aliens admission to the state bar. This case involves a *federal law* rule, not a state law rule. And while the rule at issue in *Leclerc* and *Wallace* effects a complete denial of the opportunity to obtain a license to practice law in the State, the rule at issue here merely limits an attorney's activities before PTO to those the attorney may lawfully perform under his or her visa. There is therefore no reason to hold the petition in this case pending the disposition of the petitions in *Leclerc* and *Wallace*.[1]

b. Petitioner's remaining equal protection arguments are also without merit. Petitioner contends (Pet. 17) that the court of appeals erred in holding that PTO's limited-recognition rule does not violate equal protection because it treats all nonimmigrants the same. That contention rests on a mischaracterization of the court of appeals' decision. The court of appeals noted that petitioner offered no evidence that she was treated any dif-

[1] The Court has issued an order inviting the Solicitor General to file a response to the petitions in *Leclerc* and *Wallace*. That response has not yet been filed.

ferently from other nonimmigrant attorneys with work restrictions. Pet. App. 9a. But it did not reject petitioner's equal protection claim solely on that basis. Instead, the court of appeals rejected petitioner's equal protection claim only after applying rational basis review and concluding that PTO's rule is rationally related to a legitimate government interest. *Ibid.*

Petitioner contends (Pet. 18) that there is no rational basis for PTO's rule. But as the court of appeals explained, PTO's rule is rationally related to the legitimate government interest of "minimizing the unauthorized practice of law before the PTO and its attendant public harm." Pet. App. 9a.

Petitioner argues (Pet. 18-19) that there is "no evidence" to support the conclusion that PTO's rule serves to minimize the unauthorized practice of law. That argument misunderstands the nature of rational basis review. Under the rational basis standard, PTO was not required to supply evidence to support its rule. It is enough that PTO could reasonably presume that its rule would help to achieve its desired goal. *Mathews*, 426 U.S. at 83. That standard was satisfied here. PTO could reasonably presume that its rule would help to ensure that nonimmigrant attorneys would confine their activities on matters before the agency to those that the attorneys may lawfully pursue under their visas. The court of appeals therefore correctly rejected petitioner's equal protection claim, and review of that issue is not warranted.

3. Review is also not warranted in this case because of events that have transpired since the decision below. On October 4, 2006, petitioner informed PTO that she had been granted permanent residency on September 25, 2006. Letter of Oct. 4, 2006, *supra*. As a permanent

resident, petitioner became eligible for full recognition. 37 C.F.R. 11.6(a). On December 11, 2006, PTO granted petitioner full recognition. Letter of Dec. 15, 2006, *supra*. Whether or not petitioner's change in status and her receipt of full recognition make her challenge to the limited-recognition rule at issue in this case moot, it eliminates the rule's practical effect on her and makes this case a particularly inappropriate vehicle for resolving the challenges to the rule that petitioner seeks to present.[2]

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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JANUARY 2007

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[2] For the reasons explained in text, this case is not worthy of review regardless of whether the case is now moot. Accordingly, there would be no reason for this Court to grant the petition for a writ of certiorari and vacate the judgment below even if the Court were to conclude that the case is moot. Compare, *e.g.*, *Velsicol Chem. Corp.* v. *United States*, 435 U.S. 942 (1978) (denying certiorari), with, *e.g.*, *United States* v. *Munsingwear, Inc.*, 340 U.S. 36, 39-41 (1950) (discussing vacatur on grounds of mootness); see U.S. Br. in Opp. at 4-11, Velsicol, *supra* (No. 77-900); Robert L. Stern et al., *Supreme Court Practice* 327, 830 & n.30 (8th ed. 2002).

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No. 06-338

In the Supreme Court of the United States

CATHERINE LACAVERA

Petitioner,

v.

JOHN W. DUDAS,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY BRIEF

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REPLY BRIEF FOR PETITIONERS

In an attempt to justify the *ultra vires* and unconstitutional USPTO rules pertaining to the registration and limited recognition of aliens, the respondent erroneously asserts that the USPTO granted petitioner limited recognition that was "consistent" with her visa. The limits of petitioner's limited recognition were never consistent with any of her visas and were far more restrictive. The USPTO changed the limits of petitioner's recognition in response to petitioner's challenges to those limits in an *ex post facto* attempt to make the limits appear less burdensome and more "consistent" with her visas, but the USPTO never achieved consistency.

The respondent cannot distinguish the USPTO rules at issue here from the state bar rules at issue in *Leclerc* and *Wallace*, and these cases should be reviewed by the Court together.

This case is not moot. Although the USPTO finally registered petitioner, her registration is still improperly conditioned on her maintaining her immigration status and residency in the United States. Without this Court's review, the USPTO could change its rules and policies, as it has done repeatedly during the course of this lawsuit, to restrict further the employment opportunities of petitioner and other aliens. For these reasons, the Court should grant the petition for a writ of certiorari.

REPLY TO RESPONDENT STATEMENT

1. Congress did not delegate to the USPTO authority over matters of citizenship and immigration. The USPTO is authorized to evaluate an attorney's competency to practice before it, not the terms of the attorney's visa.

The respondent mistakenly cites 37 C.F.R. §§ 11.6-11.9 as the rules applicable to this appeal. *See* 69 Fed. Reg. 35428 (June 24, 2004). The prior rules, 37 C.F.R. §§ 10.6-10.9 (2003), were applied to petitioner. (A3 n. 1.) The USPTO changed the rules in an *ex post facto* attempt to justify and

entrench in the rules the USPTO's discriminatory treatment of nonimmigrant aliens. Limited recognition was revised to apply to nonimmigrant aliens, whereas the prior rule did not refer to nonimmigrant aliens. (*Compare* 37 C.F.R. § 11.9 *and* 37 C.F.R. § 10.9 (2003)). The limits the USPTO imposed on petitioner's recognition are not part of the current or former USPTO rules and were not defined pursuant to any notice-and-comment rulemaking procedures. The USPTO defined these limits on a case-by-case basis each time petitioner changed or renewed her visa or renewed her limited recognition. (*See e.g.*, A25-27, SRA 5.)

2. a. Respondent mistakenly claims that petitioner's limited recognition was "consistent" with her visa. In fact, the USPTO never granted Lacavera limited recognition that was "consistent" with her visa. The USPTO imposed limits on Lacavera's recognition that were far more restrictive than her visas. For example, the USPTO limited Lacavera to preparing and prosecuting patent applications wherein "the patent applicant is the client of the White & Case law firm" and "the attorney or agent of record in the applications is a registered practitioner who is a member of the White & Case law firm." (*See e.g.*, A25-27.) Her visas never restricted her to representing only patent applicants, as opposed to assignees or other persons having business before the patent office. (*See e.g.*, A42, A46-63.) Her visas also never required her to work under the supervision of a fully registered patent practitioner who also was of record. *Id.* The USPTO also required Lacavera to renew her limited recognition annually, despite the fact that her H1-B visas were valid for three years. (*See* A25-27, A203-207.) Unlike registered practitioners, Lacavera did not receive a registration number and did not appear on the roster of registered attorneys maintained by the USPTO. As a result, she was required to prove her limited recognition status by filing a copy of her limited recognition papers in each patent application she prosecuted. (A27.)

None of these limitations were required by her visas. (*See e.g.*, A42, A46-63.) When petitioner began working for Google Inc. in 2005 (not 2003 as indicated by respondent (Brief for the Respondent in Opposition ("Opposition"), at 3)), the USPTO limited Lacavera to "prepar[ing] and prosecut[ing] patent applications wherein the *assignee of record of the entire interest* is Google, Inc. [sic]." (SRA 5 (emphasis added.)) In contrast, Lacavera's visa allowed her to act on Google's behalf to prepare and prosecute patent applications regardless of the assignee of record. (SRA 1-4.)

The USPTO lifted some of these limits in response to petitioner's challenges (*see* Petitioner's Petition For a Writ of Certiorari ("Petition"), at 12 n 5.), but it was never fully consistent with her visas.

b. In contrast to limited recognition, which was inconsistent with petitioner's visas, full registration is consistent with all of petitioner's visas. All of petitioner's visas authorized her to practice as a patent attorney before the USPTO. (*See e.g.*, SRA 1-4, A42, A46-63.) Nothing in any of her visas has ever prevented her from being registered as a patent attorney. *Id.* Registration as a patent attorney does not exempt her from complying with her visa restrictions.

c. Registration as a patent attorney also does not authorize petitioner to exceed her visa restrictions. Registration as a patent attorney is granted subject to compliance with all laws, including immigration laws. The USPTO has no authority to permit petitioner to exceed her visa. Petitioner is limited to the terms of her visas irrespective of any action by the USPTO.

3. Respondent omits that Petitioner's application for permanent residence status was granted on September 25, 2006, twenty days after she filed her Petition. Letter from Lacavera to Harry I. Moatz, Director of Enrollment and Discipline, USPTO (Oct. 4, 2006). Respondent sought three

extensions of time before finally filing its Opposition on January 16, 2006. In the meantime, on December 11, 2006, the USPTO granted petitioner registration as a patent attorney. Letter from Shirley A. Martin, Enrollment Program Specialist, Office of Enrollment and Discipline, USPTO, to Lacavera (Dec. 15, 2006). Lacavera's registration as a patent attorney is still conditioned upon her visa status as a permanent resident and her continued residence in the United States. *See* 37 C.F.R. 11.6(a) ("alien may remain registered only: ... [i]f the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which alien continues to lawfully reside in the United States"); *see also* Letter from Shirley A. Martin, Enrollment Program Specialist, Office of Enrollment and Discipline, USPTO, to Lacavera (Oct. 24, 2006).

REPLY TO RESPONDENT ARGUMENT

I. The Statutory Authority Of The USPTO To Limit The Recognition Of Aliens Should Be Reviewed

1. The USPTO lacks the statutory authority to limit the recognition of aliens seeking registration to practice before it. Congress authorized the USPTO to evaluate attorneys' competency, not their citizenship, immigration status or residency. Not only is the USPTO not authorized to evaluate immigration status, it is not capable of doing so properly, as the facts of this case demonstrate. After over four and half years of pendency of this dispute, despite making multiple changes to its rules, policies and the limits of petitioner's recognition, the USPTO never achieved "consistency" between petitioner's visa and her limited recognition. Petitioner's limited recognition was far more restrictive than her visas.

The respondent misapplies the holding in *Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984) to argue that the USPTO's rules must be upheld as long as they are reasonable. (Opposition, at 8.) On the

contrary, since Congress expressly limited the requirements the USPTO may impose on applicants for registration, and those requirements do not include U.S. citizenship, residency or immigration status, the USPTO has no discretion to impose such requirements. *Id.* at 842-43 ("If the intent of Congress is clear, that is the end of the matter; for the court, as well as the agency, must give effect to the unambiguously expressed intent of Congress."). Moreover, the USPTO rules are not reasonable: they are arbitrary and arbitrarily applied. It is arbitrary for the USPTO to expressly limit aliens to the terms of their visas, as the USPTO interprets those limits, when it does not expressly limit applicants for registration to complying with any other laws. The USPTO is also arbitrary in its imposition of limits to recognition of aliens that it defines on a case-by-case basis and that are more restrictive than their visas.

The USPTO is not merely recognizing limits imposed by the DHS but is attempting to interpret and enforce those limits and failing to do so properly. The USPTO refuses to register nonimmigrant aliens for the purported purpose of preventing them from exceeding their visas. It attempts to interpret aliens' visas and imposes limits on their recognition based on its faulty interpretation, as seen in this case. The USPTO is interfering with the authority of the DHS by imposing limits on nonimmigrant aliens that exceed the limits imposed by the DHS.

Registration as a patent attorney does not give petitioner any "cover to hold herself out as something she truly is not." (Opposition, at 8.) Registration establishes qualifications to practice before the USPTO, not immigration status. Petitioner was fully qualified for registration, regardless of her immigration status, when she met all of the legal, technical and character requirements for registration and passed the examination. (*See* A111, A120, A181.) She was entitled to receive full registration in order to establish her

qualifications to practice, not her immigration status. A license to practice before the USPTO cannot be mistaken for a license to work in the United States because the USPTO has no authority to grant a work visa. Petitioner is fully admitted to practice before several state bars and federal courts, including this Court, none of which afford her any improper "cover" or establish anything other than her qualifications to practice. The USPTO itself registers Canadians living in Canada who have no authorization to work in the United States (*see* 37 C.F.R. § 11.6(c); *see also* 37 C.F.R. § 10.6(c) (2003)), so there is no reason for the USPTO to deny nonimmigrant aliens registration based on their limited authorization to work in the United States.

II. The Standard Of Review Of Federal Agency Rules Disadvantaging Aliens Should Be Reviewed

2 a. This Court is not limited to mere "rational review" of federal agency rules discriminating against aliens where, as here, the agency has no special interest in immigration and naturalization. The respondent is mistaken in arguing that *Mathews v. Diaz*, 426 U.S. 67 (1976) limits this Court to only "rational review." (Opposition, at 9.) *Mathews* concerned the constitutionality of an act of Congress, the Social Security Act, and the Court recognized that the broad power of Congress over naturalization and immigration permitted only a narrow standard of review over its decisions in that area. *Mathews,* 426 U.S. at 79-82. The present challenge concerns the constitutionality of a discriminatory rule enacted by a federal agency that possesses no authority over naturalization and immigration.

The USPTO's interest in ensuring competency of registered practitioners and minimizing unauthorized practice before it is no different than the interest of every state bar, including the state bar of Louisiana that is involved in the *Leclerc* and *Wallace* cases. Since the USPTO has no special national interest that would justify a more deferential standard

of review of its discriminatory rule, at least "heightened scrutiny," if not "strict scrutiny," should have been applied to the USPTO rule denying registration to nonimmigrant aliens. *Cf. Hampton v. Mow Sun Wong*, 426 U.S. 88, 101-105 (1976); *cf. Ramos v. U.S. Civil Service Comm'n*, 376 F. Supp. 361, 366 (D.P.R. 1974), *aff'd in relevant part*, 426 U.S. 916 (1976).

The respondent seeks to distinguish *Hampton*, *Leclerc* and *Wallace* on the ground that those cases involve total denials of employment opportunities, whereas the USPTO grants "limited recognition," the limits of which it defines on a case-by-case basis. Denying employment opportunities might be more burdensome than granting limited opportunities, depending on the limits the USPTO chooses to impose, but anything less than full registration to practice before the USPTO, without limits or conditions, is unequal treatment that requires the review of this Court. While the USPTO has gradually lifted the limits it imposed on petitioner in response to Lacavera's challenges to those limits (*see* Petition, at 12 n. 5.), without direction to the contrary by this Court, the USPTO would have judicial sanction to revert to its former position or impose further, more burdensome limits on aliens.

III. The USPTO's Unequal Treatment Of Aliens Should Be Reviewed

b. Petitioner never argued that she was being treated differently than other nonimmigrant aliens with work visa restrictions. The USPTO discriminates against all nonimmigrant aliens equally by wrongly denying registration to all of them. The USPTO's refusal to register nonimmigrant aliens is not even rationally related its claimed interest in "minimizing the unauthorized practice of law before the [US]PTO and its attendant public harm." (Opposition, at 11.) The USPTO has no reason to presume that aliens are any more likely to engage in unauthorized practice before it than any other applicant for registration.

There is no reason for the USPTO to presume that registering nonimmigrant aliens as patent attorneys would induce them to violate their visas or engage in any other unauthorized practice. No other state bar or federal court was concerned that granting petitioner full admission to practice before it would induce her to violate her visas.

There is no rational basis for the USPTO to single out nonimmigrant aliens and expressly limit their recognition to their visas terms, as the USPTO interprets those terms, when the USPTO does not expressly limit recognition to the terms of any other law. There is no reason for the USPTO to presume that aliens are more likely to violate their visas than any other applicant for registration is likely to violate any other law. The USPTO's discriminatory rule rests on a baseless presumption that aliens are more likely to be guilty of unauthorized practice before it than other applicants for registration.

IV. This Case Is Not Moot

3. This case is not moot because this Court still has the power to grant petitioner a meaningful remedy by striking down the USPTO rules to the extent that they impose immigration status and residency conditions on petitioner's registration as a patent attorney. Mootness turns on whether this court can award petitioner any effectual relief. *See e.g.*, *Church of Scientology of California v. United States*, 506 U.S. 9, 12 (1992) (citations omitted). Although the USPTO did finally register petitioner as a patent attorney over four and half years after she met all of the requirements for registration (Letter of Dec. 15, 2006, *supra*; A181), her registration is still improperly conditioned on her maintaining her immigration status and residency in the United States. *See* 37 C.F.R. § 11.6.

This case is also not moot because the USPTO could change its rules and policies, as it has done repeatedly during the course of this lawsuit, to impose other, more burdensome,

limits on petitioner and other aliens seeking registration to practice before it. Thus, the USPTO has not met its heavy burden of establishing this case is moot. *See Friends of the Earth, Inc. v. Laidlaw Envtl. Servs. (TOC), Inc.*, 528 U.S. 167, 189 (2000). Without this Court's review, the USPTO or any other federal agency with no authority over immigration matters would be judicially sanctioned to restrict the employment opportunities of aliens.

Even if this case were otherwise rendered moot, it falls into the exception to mootness because the issues presented are "capable of repetition yet evading review." *See e.g.*, *Honig v. Doe*, 484 U.S. 305, 318 (1988) (citations omitted); *Roe v. Wade*, 410 U.S. 113, 125 (1973). The USPTO's refusal to register petitioner is "capable of repetition." If petitioner resides outside of the United States or her immigration status changes such that she is no longer an immigrant alien, her registration as a patent attorney will be revoked. *See* 37 C.F.R. 11.6(a). The USPTO appears to recognize that this issue is "capable of repetition" because it has already warned petitioner as follows: "If you cease to maintain permanent residence status in the United States, even temporarily, you must promptly notify the Director. *See* 37 C.F.R. 10.23(c)(14)." Letter of Oct. 24, 2006, *supra*. Section (c)(14) of USPTO rule 10.23 provides that it is misconduct to "[k]nowingly fail[] to advise the Director [of the USPTO] in writing of any change which would preclude continued registration under § 10.6 [now § 11.6]."

This Court has stated that the purpose of the "capable of repetition" test is to determine "whether the controversy was *capable* of repetition and not . . . whether the claimant had demonstrated that a recurrence of the dispute was more probable than not." *Honig*, 484 U.S. at 320 n.6 (emphasis in original) (citing numerous cases in which this Court "found controversies capable of repetition based on expectations that, while reasonable, were hardly demonstrably probable.") It is

certainly possible that petitioner's immigration status or residency could change. She is employed by a global company with offices around the world. (SRA 2.) Her previous employer was a global law firm with offices around the world. (A61.) She has already relocated for employment from Canada to New York and then to California. (A 61-62; SRA 2.)

The USPTO's refusal to register nonimmigrant aliens also "evades review" because nonimmigrant status is temporary and therefore aliens who intend to remain in the United States must seek immigrant status. Petitioner's TN nonimmigrant visas were valid for one year (*see e.g.*, A81) and her H1-Bs visas were valid for three years (*see e.g.*, SRA 1), subject to renewal. Although the time it takes to attain immigrant status is variable, it can be too brief to obtain review. Petitioner's current employer sponsored her application for immigrant status that was granted twenty days after petitioner filed the Petition and less than a year after the application was filed. Letter of Oct. 4, 2006, *supra*. Petitioner's prior employer sponsored her application for immigrant status (Corrected Brief for Plaintiff-Appellant at 3 n. 1) but that application was still pending three and a half years later when she changed employers (SRA 1).

Even if this case was rendered moot by the USPTO's registration of petitioner as a patent attorney, the petition for a writ of certiorari should be granted and the judgments below vacated to clear the path for future litigants to challenge the USPTO rules pertaining to registration and limited recognition of aliens.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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No. 06-338

In the
Supreme Court of the United States

CATHERINE LACAVERA,
Petitioner,

v.

JONATHAN W. DUDAS, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF *AMICUS CURIAE* FOR THE COALITION OF SERVICE INDUSTRIES, INC., IN SUPPORT OF PETITIONER

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October 2006

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Brief *Amicus Curiae* of the Coalition of Service Industries, Inc.

I. THE INTEREST OF THE *AMICUS CURIAE*

The Coalition is an incorporated non-profit membership association organized under and existing pursuant to the laws of the District of Columbia.[1] It is an advocacy organization dedicated to the reduction of barriers to U.S. services exports including legal services, and to the development of constructive domestic U.S. policies to enhance the global competitiveness of its members. Since its formation in 1982 the Coalition has worked with and offered advice on trade issues to U.S. government agencies such as the Office of the United States Trade Representative ("USTR") and the Departments of Commerce and Treasury.[2]

Robert Vastine, President of the Coalition since 1996, previously served in various Congressional staff posts and as Deputy Assistant Secretary of the Treasury for International Trade and Raw Materials Policy. He has authored many publications on U.S. trade policy. He chairs the official Industry Trade Advisory Committee for International Trade in Services and chaired its pre-2004 predecessor, Industry Sector Advisory Committee 13. Representatives of Coalition members, including members of its Legal Services Committee, also have experience on

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1 All parties have consented in writing to the filing of this brief. No counsel for a Party authored any part of the Brief. No person other than the Coalition, its members or counsel made a monetary contribution to its preparation or submission.

2 A chronology of CSI interaction with government agencies from April 2003 to 2006 appears at Services Drive Growth, Recent CSI Events, http://www.uscsi.org/meetings/.

these advisory committees. At almost monthly meetings the committees receive briefings from USTR and other agencies respecting progress and foreign objections in their negotiations and provide recommendations to them on how to meet the objections and on affirmative industry goals.

With the Department of Commerce, the Coalition has co-sponsored annual symposia on the progress and goals of the negotiations.[3] It cooperates with like-minded private sector organizations such as the European Services Forum and the Australian, Brazilian, Canadian, Chilean, Hong Kong and Japanese services organizations.

The Coalition and its members thus have a unique basis within the private sector to address the importance of the Questions Presented. The Coalition views the United States Patent and Trademark Office ("USPTO") rule excluding legally admitted non-immigrant aliens from full registration before the patent bar as a probably significant obstacle to negotiating more liberal rules for trade in legal and possibly other services in ongoing U.S. negotiations in the World Trade Organization and in other multilateral and bilateral negotiations.

The Coalition has the same interest in the Questions Presented in pending petitions in *Caroline Wallace and Emily Maw v. Paul Calogero, Jr., et al.* and *Karen Leclerc, et al. v. Daniel E. Webb, et al.*, Nos. 05-1645 & 06-11. In those cases the Coalition has filed a Motion for Leave To File a Brief *Amicus Curiae* and Brief *Amicus Curiae*. The

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[3] For example, the January 12, 2005, symposium, held in the Main Auditorium of the Department of Commerce, was entitled "Services Liberalization in the Doha Round: U.S. Industry Priorities", http://www.uscsi.org/meetings.

Coalition's brief in those cases and this brief address only the importance of the Questions Presented.

II. SUMMARY OF ARGUMENT

The USPTO rule at issue here discriminates on the basis of nationality against foreigners legally resident in this country.[4] Americans, permanent resident aliens, and foreigners living abroad can fully practice in the patent bar. Legally admitted temporary resident aliens cannot. The rule runs counter to the growing trend in international relations not to discriminate on the basis of nationality. United States trade negotiators support that trend, convinced that our country will benefit from it.

The U.S. has for example asked many other nations not to discriminate against American lawyers who provide or wish to provide legal services in foreign countries. Because reciprocity plays a large role in trade negotiations, the USPTO rule adversely affects our legal community in the several important trade negotiations that are currently underway or planned.

While the backlash will focus on legal services, it could prejudice our negotiations in other sectors as well. In any event, the direct monetary value of American legal services provided abroad is itself substantial. Moreover, of even greater value are the investments and commercial transactions that American businesses are likely to make

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[4] "National Treatment" means that each WTO Member "shall accord to services and service suppliers of any other Member, in respect of all measures affecting the supply of services, treatment no less favorable than it accords to its own like services and suppliers." General Agreement on Trade in Services, Article XVII, http://www.wto.int/english/docs_e/legal_e/26-gats.pdf.

abroad if they can obtain assistance from American lawyers and law firms whom they know and trust.

Expansion of our foreign trade is of large national importance. As the Associated Press reported on July 11, 2006, newly appointed Secretary of the Treasury Henry Paulson pledged "to make sure the country does not retreat from the global economy", remarking that "the strength of the U.S. economy is linked to the strength of the global economy." He cautioned that "If we retreat from the global stage, the void is likely to be filled by those who do not share our commitment to economic reform." He added that he planned to expand trade and investment.

Few aspects of supplying American legal services to foreign nations are protected by treaty, and they are vulnerable to domestic protectionist elements that try to exploit the discrimination inherent in the USPTO rule. Some nations already affirmatively prohibit or substantially constrain the provision of American legal services and preclude foreign members of their bars from practice before their patent offices. The ongoing treaty negotiations could, if successful, gain treaty protection for existing practices and open up markets that are closed.

There thus is an important national interest at stake in whether the USPTO rule will be allowed to stand. That interest argues strongly for review by this Court.

III. ARGUMENT

A. Delivery of American Legal Services Abroad Is of Substantial Value to the Nation's Legal Community and Economy

The value of cross-border exports of U.S. legal services has increased for many years and stood at $3.9 billion for 2004, while cross-border imports declined to $754 million. For 2003, the latest year for which relevant data are available, the value of legal services provided to foreigners by U.S. law firm offices abroad was $1.1 billion.[5] Today at least 107 U.S.-based law firms have an aggregate of at least 460 foreign offices.[6] Accordingly, the United States, and U.S. lawyers and law firms, have a substantial monetary interest in exports of legal services.

The experience of the Coalition and its members indicates that many of the consumers of such services are U.S. entities doing business abroad. They generally prefer to receive legal assistance from firms with which they are familiar, firms that are knowledgeable about U.S.-law aspects of what they are doing and what they are constrained from doing.[7] Thus U.S. based law firms

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[5] United States Department of Commerce, Bureau of Economic Analysis, October 2005 Survey of Current Business, U.S. International Services; Cross-Border Trade in 2004 and Sales Through Affiliates in 2003, at 25, 28, 30, 40, 45-46,75, http://bea.gov/bea/pub/1005cont.htm

[6] These figures are based on a review of Martindale-Hubbell Law Directory 2006 listings for San Diego, San Francisco, and Los Angeles, California, New York, New York, and Washington, D.C. Though incomplete, the figures probably suggest the magnitude of U.S. law firms' current and potential future foreign operations.

[7] *See, e.g.*, Collective Request-Legal Services, March 2006, 1. Introduction, http://www.uscsi.org/wto/crequests.htm "In addition

substantially facilitate the making of foreign investments, innovation and technology transfer, and the conduct of business abroad, as well as compliance with applicable constraints imposed by U.S. law. In view of the magnitude of foreign investments and transactions for which U.S. lawyers and firms provide legal services, the importance of exports of legal services to the U.S. economy is far greater than the dollar value of those services themselves, although harder to quantify.

B. Delivery of American Legal Services Abroad Is an Important Issue in Pending Treaty Negotiations

USTR has recognized the importance of exporting legal services in its trade negotiations for many years. The starting point for such negotiations is the fact that American lawyers and law firms enjoy few treaty rights to establish offices and to practice U.S. or local domestic law abroad. It was not until the Uruguay Round Agreements of 1994 that services were addressed in negotiations conducted under the auspices of the General Agreement on Tariffs and Trade, established in 1947. The Uruguay Round Agreements include the General Agreement on Trade in Services ("GATS") and established the World Trade Organization ("WTO") as the institutional successor to GATT.

In recognition that it had achieved very limited liberalization in services, GATS called for the reopening of services negotiations beginning in 2000. USTR began public preparations for renewed negotiations with a Federal

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to contributing to a business-friendly environment for investment, greater foreign investment is encouraged if host-country regulatory systems permit investors to have access to their own legal advisers."

Register notice and request for comments on objectives on March 28 of that year.[8] USTR continues to pursue those negotiations today, as part of what is known as the Doha Round. In this context the Coalition has continued to work closely with U.S. negotiators[9] and foreign private-sector interests to bring about significant liberalizations of legal services among others.

WTO negotiations involve both requests for and offers of liberalization. In March 2003 the U.S. requested the developed-nation Members of the WTO to afford broad rights to U.S. lawyers and law firms to practice U.S. law including international law and the right to take bar examinations in and practice domestic law on the same terms and conditions that apply to a Member's own citizens.[10] The U.S. has also joined with Australia, Canada, the EC, Japan, New Zealand and Norway in a Collective Request for similar liberalization. This request seeks among other things removal of nationality requirements and consideration of "permitting foreign lawyers, subject to satisfying domestic licensing requirements, the right to provide legal services in domestic law.[11] These requests do not anticipate amendment of the WTO treaty so as to

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[8] *See*, Trade Policy Staff Committee, Public Comments for Mandated Multilateral Trade Negotiations on Agriculture and Services in the World Trade Organization (WTO) and Priorities for Future Market Access Negotiations on Non-Agricultural Goods, Notice and Request for Comments, 65 F.R. 16450 (2000).

[9] The principal U.S. negotiators work at USTR. They cooperate with the Departments of Commerce and Treasury, in consultation with other authorities including the Department of Justice.

[10] The U.S. has not made the request public, but a summary of it appears at http://abanet.org/cpr/gats/us_gats/us_requests.doc.

[11] *See*, Collective Request-Legal Services, http://www.uscsi.org/wto/crequests.htm.

require all WTO Members to comply with them. Rather, the requests seek voluntary binding agreements by individual Members that they will afford the requested access and treatment.

USTR had known for years that agreement in the Doha Round might be delayed because of difficulties in reaching agreement in the agricultural sector. While nonetheless still actively seeking agreement in the Round, USTR has also negotiated, and is today negotiating bilateral and regional free trade agreements.[12] USTR has sought in these negotiations the same liberalized access to foreign markets for American lawyers as set forth in its Request to WTO Members and in the Collective Request.

C. If Allowed To Stand, the Decision Below Is Likely To Adversely Affect U.S. Efforts To Obtain Further Liberalization in Trade in Services, Particularly Legal Services.

Reciprocity naturally plays a large role in trade negotiations. For examples, Australia's WTO May 26, 2005, Revised Service Offer for legal services is expressly and "in particular . . . conditional upon the degree of liberalization proposed in the same sectors in the offers of other WTO Members", and the EU's Conditional Revised Offer "is conditional on other WTO Members making

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[12] *See, e.g.*, U.S. Hopes Central American Trade Pact Takes Effect "Very Soon", http://usinfo.state.gov/wh/Archive/2006/Jun/05-961219.html; *USTR Portman Prepares Congress for OMAN Deal* (March 31, 2006), http://www.texasfairtrade.org/article.php?story=20060331093406816&mode=print.

substantive offers in sectors where the EU has made requests."[13]

The USPTO rule at issue here is a matter of widespread concern among other WTO Members. *See, e.g.,* GATS 2000, Request from the EC and Its Member States, Professional Services, EC Request to the United States of America, A. LEGAL SERVICES (March 2003) (asking for removal of citizenship requirements to practice before the U.S. Patent and Trademark Office), http://www.gatswatch.org/requests-offers.html#outgoing. Obviously the U.S. is in no position to press other nations to open their patent office practices to U.S. lawyers who qualify for their bars so long as the USPTO rule stands.

The negotiating difficulties that the U.S. faces are aggravated by the lack of any demonstrated or plausible justification for the USPTO rule. Respondent has adduced no evidence, and has not even asserted that non-immigrant aliens have in fact acted improperly respecting the practice of law. Mere conjecture as to possibilities can justify a host of protectionist measures. The United States should not lend its aid to protectionist tendencies abroad.

It is also quite possible that the decision below would prejudice the U.S. in free trade negotiations in sectors in addition to the legal services sector. Protection of intellectual property rights around the world is obviously of great importance to American business enterprises. Their lack of access to relevant services of American lawyers abroad could adversely impact achieving Administration and U.S. goals of increasing America's foreign trade and investment.

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[13] http:www.uscsi.org/wto/. The public offers of many additional Members are available at this site.

IV. CONCLUSION.

The foregoing considerations respecting the importance of the Questions Presented favor issuance of the writ of certiorari.

Respectfully submitted,

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